



D-1083

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Previous Appeal No.: **2004-1711**)  
In re Application of )  
**Frazzitta, et al.**)  
Application No.: **08/889,033**) Art Unit 2613  
Confirmation No.: **2912**)  
Filed: **July 7, 1997**) Patent Examiner  
Title: **Transaction System**) Tung Vo

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**THIRD BRIEF OF APPELLANTS  
PURSUANT TO 37 C.F.R. § 41.37**

Sir:

The Appellants hereby submit their Third Appeal Brief pursuant to 37 C.F.R. § 41.37 concerning the above-referenced Application. This Third Appeal Brief is in response to the Office Action dated October 27, 2005, which reopened prosecution following a prior decision (dated July 21, 2005) in this application by the Board of Patent Appeals and Interferences ("Board") in Appeal No. 2004-1711.

(i)

**REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is  
Diebold, Incorporated, an Ohio corporation.

(ii)

## **RELATED APPEALS AND INTERFERENCES**

This Appeal Brief is the result of the Examiner reopening prosecution following a prior decision in this application by the Board in Appeal No. 2004-1711. The decision was decided on July 21, 2005. Appellants, Appellants' legal representative, and assignee believe that there are no further related appeals or interferences pertaining to this matter.

(iii)

### **STATUS OF CLAIMS**

Claims 1-47 are pending in the Application.

Claims rejected: 1-44

Claims allowed: 45-47

Claims 45-47, being neither rejected nor objected to, must be presumed allowed. No further discussion thereof is deemed necessary.

Claims confirmed: none

Claims withdrawn: none

Claim objected to: none

Claims canceled: none

Appellants appeal the rejections of claims 1-44, inclusive. These rejections were in the Office Action (“Action”) dated October 27, 2005. Claims 45-47 are allowed.

(iv)

## **STATUS OF AMENDMENTS**

The Action dated October 27, 2005 reopened prosecution following decision by the Board. Appellants' remarks in their 2nd Appeal Brief filed October 2, 2001, and their acknowledgment comments filed August 10, 2005, are incorporated herein by reference.

The Action dated October 27, 2005 was not made final. Thus, no amendments to the claims were requested to be admitted after a final rejection.

**(v) SUMMARY OF CLAIMED SUBJECT MATTER**

*Concise explanations of exemplary forms of the claimed invention:*

For reasons of brevity, claim language may be referred to herein (and in Appellants' arguments) in a shortened version. For example, language such as "at least one" may be simply referred to as "a". Any generalized statement in this Appeal Brief is not to limit any of the mentioned claims in any manner. Please refer to the specific claim for the exact claim language.

With respect to independent claim 1

An exemplary form of the invention is directed to a transaction system. The transaction system (e.g., 10; Figures 1-12) includes a service provider (SP) station (e.g., 14) enabled to be operated by a service provider (e.g., 16) providing a transaction (e.g., Specification page 8 line 21-page 9, line 3). The SP station includes therein a device (e.g., 28) for delivering and receiving a carrier (e.g., 26) (e.g., page 9, lines 12-14). The SP station also includes at least one component of an SP visual display (e.g., 42), an SP camera (e.g., 44), an SP audio transmitting device (e.g., 46), and an SP audio receiving device (e.g., 46) (page 10, line 15-page 11, line 8).

The system also includes at least one customer station (e.g., 18) enabled to be operated by a customer (e.g., 20) requesting a transaction (e.g., page 9, lines 4-6). The customer station (like the SP station) also includes therein a device (e.g., 24) for delivering and receiving the carrier (26) (e.g., page 9, lines 9-12). The customer station additionally includes at least one component of a customer visual display (e.g., 80), a customer camera (e.g., 84), a customer audio transmitting device (e.g., 86), and a customer audio receiving device (e.g., 86) (e.g., page 15, lines 11-16).

The SP carrier delivery and receiving device (28) is in operative connection with the customer carrier delivery and receiving device (24) enabling a carrier (26) carrying a transaction item to be selectively moved between the customer station's carrier delivery and receiving device (24) and the SP station's carrier delivery and receiving device (28) (e.g., page 10, lines 9-14).

The transaction system (10) further includes a building (e.g., 12). The SP station (14) and the customer station (18) are both positioned inside of the building (12) (e.g., page 8, lines 14-16). Further description related to the exemplary form of the invention may be found, for example, in Figures 1-12 and corresponding text.

With respect to independent claim 28

Another exemplary form of the invention is directed to a transaction system (e.g., 10) including a customer station (e.g., 18) produced by a method. Claim 28 is a product by process claim. Support in the disclosure for like reference numerals has previously been provided.

The method of producing includes providing an interior building wall (e.g., 38; Figure 10; page 10) including a wall opening (e.g., 96; Figure 5; page 18) therethrough (e.g., page 10, lines 4-8; page 18, lines 1-6). The method also includes positioning a frame (e.g., 94; Figures 5-7) in the wall opening (96) in supporting connection with the wall (38) (e.g., page 18, lines 1-6). The method further includes positioning at least one customer station transaction component (e.g., carrier and delivery device 24, visual display 80, camera 84) in supporting connection with the frame (94) (e.g., page 19, lines 3-10). The method additionally includes mounting a cover (e.g., 68; Figure 1) in supporting connection with the wall (38) in overlying relation of the wall opening (96) (e.g., page 18, lines 11-13). The cover (68) includes a component opening (e.g.,

opening 72, screen access opening 78, camera viewing opening 82, accessory opening 85) (e.g., page 15, lines 1-19). The cover (68) is mounted so that when it is in overlying relation of the wall opening (96), the customer station transaction component (e.g., 24, 80, 84, 86) is accessible through the cover's component opening (e.g., 72, 78, 82, 85) (e.g., page 15, line 3-page 16, line 8). Further description related to the exemplary form of the invention may be found, for example, in Figures 1-12 and corresponding text.

With respect to independent claim 38

Another exemplary form of the invention is directed to a system. Support in the disclosure for like reference numerals has previously been provided. The system (10) includes a service provider (SP) station (14) including an SP visual display (42), an SP CCTV camera (44), an SP audio transmitting device (46) and an SP audio receiving device (46), and an SP pneumatic tube carrier delivery and receiving device (28).

The system also includes at least one customer station (18) including a customer visual display (80) in operative connection with the SP CCTV camera (44). The customer station also includes a customer CCTV camera (84) in operative connection with the SP display (42). The customer station also includes a customer audio transmitting device (86) and a customer audio receiving device (86) in operative connection with the SP audio receiving device (46) and SP audio transmitting device (46), respectively. The customer station also includes a customer pneumatic tube carrier deliver and receiving device (24) in operative connection with the SP pneumatic tube carrier delivery and receiving device (28) enabling a carrier (26) to be selectively moved between the customer station (18) and the SP station (14).

The system also includes a building (12) comprising an interior area which includes an interior wall (38) (e.g., page 10, lines 1-8; Figures 10-11). The SP station (14) is housed in the interior area of the building (e.g., page 10, lines 1-4; Figures 10-11). At least one component among the customer visual display (80), customer CCTV camera (84), customer audio transmitting device (86), customer audio receiving device (86), and customer carrier device (24) of the customer station (18) is positioned within the interior area in supporting connection with the interior wall (38) (e.g., page 10, lines 1-8; Figure 10). Further description related to the exemplary form of the invention may be found, for example, in Figures 1-12 and corresponding text.

With respect to independent claim 41

Another exemplary form of the invention is directed to a system. Support in the disclosure for like reference numerals has previously been provided. The system (10) includes at least one customer station (18) including at least one component of a customer visual display (80), a customer CCTV camera (84), a customer audio transmitting device (86), a customer audio receiving device (86), and a customer carrier delivery and receiving device (24).

The system further includes a building (12), wherein the building comprises an interior area which includes an interior wall (38) extending therein. The at least one customer station component (e.g., 80, 84, 86, 24) is in supporting connection with the interior wall (38). The wall (38) includes an opening (96).

The customer station (18) also includes a frame (94). The frame (94) is in supporting connection with the interior wall (38) and extends in the interior wall opening (96). The at least

one customer station component (e.g., 80, 84, 86, 24) is in supporting connection with the customer station frame (94). Further description related to the exemplary form of the invention may be found, for example, in Figures 1-12 and corresponding text.

With respect to independent claim 43

Another exemplary form of the invention is directed to a system. Support in the disclosure for like reference numerals has previously been provided. The system (10) includes at least one customer station (18) including at least one component including at least one of a visual display (80), a CCTV camera (84), an audio transmitting device (86), an audio receiving device (86), and a carrier delivery and receiving device (24).

The system also includes a building (12) which comprises a wall (38). The at least one customer station component (e.g., 80, 84, 86, 24) is in supporting connection with the wall (38).

The customer station (18) further includes a cover (68) movably mounted (e.g., hinges 104; Figures 5-7) in supporting connection with the wall (38). The cover (68) includes at least one opening (e.g., 72, 78, 82, 85).

In a first position of the movably mounted cover (68), the cover generally overlies the at least one customer station component (e.g., 80, 84, 86, 24). The at least one customer station component (e.g., 80, 84, 86, 24) includes a first customer station component. In the first cover position the first customer station component (e.g., 80, 84, 86, or 24) is manually accessible through the at least one cover opening (e.g., 72, 78, 82, 85) enabling the first customer station component to be operated by a customer (e.g., 20) (page 15, lines 1-10).

In a second position of the movably mounted cover (68), the cover is disposed from the at least one component (e.g., 80, 84, 86, 24) rendering the at least one component accessible for servicing (e.g., page 18, line 14-page 19, line 12). Further description related to the exemplary form of the invention may be found, for example, in Figures 1-12 and corresponding text.

**(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

- 1). Whether claims 1-3, 12, 14-16, 18-19, and 38-40 are unpatentable pursuant to 35 U.S.C. § 103(a) as obvious over McClure, et al. (US 3,294,342) (hereinafter "McClure") in view of Granzow, et al. (US 4,580,040) (hereinafter "Granzow").
- 2). Whether claims 4-11, 20-23, 28-37, and 41-44 are unpatentable pursuant to 35 U.S.C. § 103(a) as obvious over McClure in view of Granzow and Ramachandran, et al. (US 5,483,047) (hereinafter "Ramachandran").
- 3). Whether claims 13, 17, and 24-27 are unpatentable pursuant to 35 U.S.C. § 103(a) as obvious over McClure in view of Granzow and Gallacher, et al. (US 5,661,283) (hereinafter "Gallacher").

(vii)

## ARGUMENT

### The Applicable Legal Standards

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembicza*k, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Evidence of record must teach or suggest the recited features. An assertion of knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). A rejection must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action requiring appeal does not meet these burdens.

**The 35 U.S.C. § 103(a) Rejections are legally improper**

**The rejections are devoid of any teaching, suggestion, or motivation**

Appellants traverse the rejections on the grounds that Appellants' claims recite features, relationships, and/or steps which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features, relationships, and steps recited in Appellants' claims patentably distinguish over the applied references.

**The rejections are based on hindsight reconstruction**

The only suggestion for the recited features, relationships, and steps is found in Appellants' own novel disclosure. It follows that the rejections are based solely on hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

**The Office has not established a *prima facie* showing of obviousness**

The Office has not established a *prima facie* case of obviousness. The rejections are not supported by concrete evidence of record. *In re Zurko*, supra. *In re Lee*, supra. It would not have been obvious to one having ordinary skill in the art to have modified the references as alleged to have produced the recited invention. Thus, Appellants respectfully submit the rejections are improper and should be reversed.

**The Claims Are Not Obvious Over  
McClure in view of Granzow**

Claims 1-3, 12, 14-16, 18-19, and 38-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McClure in view of Granzow.

The Action alleges that McClure teaches an SP station (18; station I or II in Figure 5) and a customer station (10). The Action (on page 4) admits that McClure does not teach or suggest an SP station and a customer station positioned inside of the same building.

The Action alleges that Granzow teaches an SP station (window teller 14) and a customer station (ATM 12) positioned inside of the same building. The Action further alleges that it would have been obvious to incorporate the alleged suggestions of Granzow, where an ATM and a teller station are both positioned inside a bank, into the system of McClure. The reason provided in the Action for the alleged modification of McClure with the teaching of Granzow is so a non-driving customer can do banking without having to wait in line at a drive through ATM.

Appellants hereinafter show that neither McClure nor Granzow, taken alone or in combination, teach or suggest the features and relationships that are specifically recited in the claims. Furthermore, even if it were somehow possible for the references to have disclosed certain features as alleged, it still would not have been obvious to have combined the references as alleged. Additionally, even if it were somehow possible (which it isn't) for the references to be combined as alleged, the combination still would not have produced Appellants' claimed invention.

For ease of following, the (earlier numbered) claims that depend on independent claim 38 have been discussed thereafter.

### Claim 1

Claim 1 is specifically directed to a “transaction system”. The claim recites an “SP station” and a “customer station” positioned inside of the same building. The claim also recites that an "SP carrier delivery and receiving device" and a "customer carrier delivery and receiving device" are in “operative connection” with each other. The claim further recites that a carrier with a transaction item can be selectively moved between the delivery and receiving devices.

An exemplary transaction system (10) is shown in Appellants' Figures 10-12. Positioned inside of the same building (12) is a service provider station (14) and a customer station (18). Each station (14, 18) has a respective carrier delivery and receiving device (28, 24). The devices (28, 24) are operatively connected by a tube (30) through which a carrier (26) carrying a transaction item can pass. Thus, not only are the SP and customer stations (14, 18) positioned inside the same building (12), but their respective carrier delivery and receiving devices (28, 24) are operatively connected enabling the carrier (26) with a transaction item to be selectively moved therebetween.

### McClure does not teach or suggest the recited features and relationships

The Action admits that McClure does not teach or suggest an SP station and a customer station positioned inside of the same building. Appellants respectfully submit that McClure actually teaches away from having an SP station and customer station inside the same building. Therefore, the alleged modification thereof to locate an SP station and a customer station inside the same building would not have been obvious to one having ordinary skill in the art.

Appellants also respectfully submit that McClure lacks more of the recited features and relationships than the Action admits. For example, McClure does not teach or suggest both an

SP carrier delivery and receiving device and a customer carrier delivery and receiving device.

McClure has (as one skilled in the art would recognize) a carrier (40) to carry a transaction item.

However, where does McClure teach or suggest having (at each station) a device to both deliver and receive the carrier? At best, McClure has a customer station door (36) with a receiver box (38) that can receive the carrier (40) (col. 4, lines 29-31; col. 5, lines 50-51, 58-59, and 65-66).

Where does McClure teach or suggest that the receiver box (38) is also used to deliver the carrier (40)? He doesn't. In McClure the customer has to manually drop the carrier (40) into the open mouth of a transmission tube (42) (which is exposed while the door 36 is open) to begin its journey by gravity (col. 4, lines 39-46).

Thus, because of the admitted and additionally noted deficiencies, McClure does not teach or suggest a building having therein a customer station including a customer carrier delivery and receiving device from which a carrier can be selectively moved. It follows that McClure cannot teach or suggest the same building having therein an SP carrier delivery and receiving device in operative connection with a customer carrier delivery and receiving device.

As discussed in more detail later, Granzow cannot alleviate the admitted and noted deficiencies in McClure. Thus, even if it were somehow possible (which it isn't) for McClure to be modified with the teaching of Granzow as alleged, the result still would not have produced the recited invention.

Granzow does not teach or suggest the recited features and relationships

Granzow (like McClure) does not teach or suggest both an SP carrier *delivery* and receiving device and a customer carrier *delivery* and receiving device. Nor does Granzow (like

McClure) teach or suggest a *building* having therein a customer station including a *customer carrier delivery and receiving device* from which a carrier can be selectively moved.

Granzow does not teach or suggest the recited SP station including an SP carrier delivery and receiving device. Nor does Granzow teach or suggest the recited customer station including customer carrier delivery and receiving device. Nor does Granzow teach or suggest the recited carrier delivery and receiving devices being operatively connected. Granzow's arrangement does not enable a carrier carrying a transaction item to be selectively moved between a customer station's carrier delivery and receiving device and an SP station's carrier delivery and receiving device.

The Action alleges that Granzow teaches a customer station (ATM 12). Granzow's ATM (12) cannot constitute the recited customer station. At best, Granzow is capable of transporting a check (90) via transport belts (92, 98) in the ATM (12). The transport belts are closely arranged to sandwich the check therebetween (col. 4, lines 5-14). One skilled in the ATM art would recognize that a slot in an ATM (like Granzow's check slot 88) is conventionally sized to only receive the sized item intended so as to prevent malicious activity and damage to the ATM. One skilled in the art of SP and customer stations (like McClure) would understand that neither Granzow's check slot (88) or belts are of sufficient structure and size to enable movement of a carrier carrying a transaction item in the manner recited. This insufficiency in Granzow is confirmed by McClure. McClure teaches that the (previously discussed) receiver box (38) "is of a *size* to accommodate" the carrier (40) (col. 4, lines 29-31).

Granzow does not discuss, mention, or need a carrier. Nor could Granzow's arrangement enable a carrier to be selectively moved. Nor could Granzow's arrangement enable *McClure's*

carrier (40) to be selectively moved. Nor does Granzow have any need of operatively connected customer and SP carrier delivery and receiving devices.

Granzow also teaches that the alleged customer station (ATM 12) is *isolated* from the alleged SP (teller) station (14) (col. 6, lines 41-42). That is, Granzow teaches that none of the features of the ATM (12) can be part of the alleged SP station (14). Thus, Granzow teaches away from the alleged SP station (14) having any carrier delivery and receiving device.

It follows that Granzow cannot teach or suggest an SP carrier delivery and receiving device operatively connected with a customer carrier delivery and receiving device enabling a carrier of a transaction item to be selectively moved between the devices. It further follows that Granzow (like McClure) cannot teach or suggest a building having therein an SP carrier delivery and receiving device operatively connected with a customer carrier delivery and receiving device enabling a carrier with a transaction item to be selectively moved between the devices.

A *prima facie* showing of obviousness has not been established

Appellants have shown that neither of the relied upon references (McClure or Granzow) teach or suggest a building having therein a customer station including a customer carrier delivery and receiving device from which a carrier carrying a transaction item can be selectively moved. Since the references, taken alone or in combination, do not teach or suggest all of the recited features and relationships, a *prima facie* case of obviousness has not been established.

Appellants have additionally shown that neither of the relied upon references, taken alone or in combination, teach or suggest a building having therein an SP carrier delivery and receiving device in operative connection with a customer carrier delivery and receiving device as recited. Nor do the references teach or suggest an SP station and customer station relationship that

enables a carrier with a transaction item to be selectively moved between respective delivery and receiving devices inside of the same building. Again, a *prima facie* case of obviousness has not been established. As the combined teachings of the individual references do not include all of the recited features and relationships, the rejection is not proper and should be reversed.

Not obvious to have modified McClure as alleged

Even if it were somehow possible (which it isn't) for the references to have disclosed the features alleged, it still would not have been obvious to have combined the references as alleged. The reason provided in the Action for the alleged modification of McClure with the teaching of Granzow is so a non-driving customer can do banking without having to wait in line at a drive through ATM. That is, the rejection is predicated on walk-up customer not having to wait in line at a drive through (exterior) ATM. However, this is not a valid reason for the alleged modification because neither McClure nor Granzow even teach or suggest a drive through ATM. Nor is inside banking a valid reason for the alleged modification because Granzow teaches having long lines inside the building (col. 6, lines 44-45).

Appellants have rebutted the Office's reason for the proposed modification of McClure. The rejection is devoid of any prior art teaching, suggestion, motivation, or valid reason for the alleged modification of McClure. Again, it would not have been obvious to have modified McClure as alleged.

It would not have been obvious to have added an ATM inside of McClure's building, as alleged by the Office. Nor has the Office shown that it is structurally and functionally possible to have added an ATM within McClure's building. McClure is directed to "the serving of bank customers at a customer service-facility *outside* the bank" (col. 1, lines 17-18, 64, and 71-72).

McClure desires that the customers stay in their auto for convenience to the customer and safety (security) for the teller (col. 1, lines 68-71; col. 2, lines 8-13). McClure requires that any customer station be kept external of the building. Hence, requiring a customer to come inside a building would go directly against the explicit advantages of McClure. Also, there is no indication that McClure's building is large enough for customer usage (especially customers in their auto).

One skilled in the art would not have placed an ATM inside of McClure's building, especially when there isn't even an ATM exterior of McClure's building. The alleged addition to McClure of an inside ATM (which could be used outside 24/7) would be inefficient, contrary to McClure's desire for outside services, and not structurally possible. McClure also teaches against customers coming inside the building. A reference teaching away from the recited invention does not support *prima facie* obviousness. McClure's teaching is not compatible with the teaching of Granzow. Again, it would not have been obvious to have placed an ATM inside of McClure's building.

Nor would it have been obvious to have added an ATM inside of McClure's building next to and in functional relation with McClure's SP station (18). Where does McClure teach or suggest having inside customers, or tellers for inside customers? Even the Action (on page 4) specifies that the SP station (18) of McClure is in a secure room.

Regardless, there is no prior art evidence of record of an SP teller handling both exterior customers *and* interior customers, which would be necessary with the proposed modification of McClure. The alleged SP station (18) in McClure is solely for servicing exterior customers (col. 6, lines 29-34). Even if it were somehow possible (for sake of argument) for McClure to have

inside customers, the remote outwardly extending building portion in McClure's Figure 1 teaches away from a person in the alleged SP station also servicing inside customers.

Furthermore, with the proposed modification (for sake of argument), McClure's SP station teller would have to simultaneously handle three different customer locations (two exterior and one interior). Yet McClure is only structurally equipped to handle two exterior customers (via stations I and II).

Even if McClure somehow had a drive-thru ATM (which he doesn't), the rejection still would not have been obvious. To believe that a driver would rather bypass a bank's convenient drive-thru ATM and leave their auto to go inside the bank (assuming the bank is even open) to use an ATM is unreasonable, illogical, and goes against the purpose and experience of the banking industry's convenient 24/7 ATM banking.

The Action is also silent as to how the dissimilar components of McClure and Granzow could be connected. Conversely, the alleged SP station (18) of McClure and the alleged customer station (i.e., ATM 12) of Granzow are incompatible. For example, how could Granzow's ATM belts (92, 98) connect to McClure's pneumatic tube (42, 56), especially to enable McClure's carrier (40) to be selectively moved with a transaction item between the added customer station (ATM 12) and the alleged SP station (18) in McClure? They can't.

Even if McClure had (for sake of argument) inside teller stations and Granzow's interior ATM (12) was added inside McClure's building, McClure's SP station (18) still would be securely isolated from the added ATM (and any teller station). Even the Action (on page 4) indicates that the SP station (18) of McClure is in a secure room.

Furthermore, there is no prior art evidence of record of using a pneumatic tube in a bank interior for a transaction item carrier (which would be necessary with the proposed modification of McClure). Nor is there any prior art evidence of record of using a pneumatic tube in an ATM (the alleged added customer station). Granzow does not teach, suggest, or require any pneumatic tube. Granzow's ATM (the alleged customer station) has conventional belts (92, 98), not a pneumatic tube.

The record lacks evidence of an ATM having a pneumatic tube instead of belts. Nor would it have been obvious to one of ordinary skill in the art to have replaced the ATM belts of Granzow with pneumatic tubes (which would be necessary in the proposed modification). Nor has the Office explained how the structure of Granzow's ATM could afford the size/space needed for a pneumatic tube operation. Cost alone would prohibit use of a pneumatic tube for such a short distance (the width of an ATM). Even present day drive-thru banking (with pneumatic tubes) uses a retractable drawer for the auto lane adjacent an SP window. The prior art of record teaches against the Action's alleged combination. It would not have been obvious to have used a pneumatic tube in Granzow's ATM (12), especially to enable movement of McClure's carrier (40) (and for such a short distance).

As it would not have been obvious to have provided Granzow's walk-up window teller (14) and ATM (12) with operatively connected devices to enable delivering and receiving a carrier with a transaction item therebetween, it would have been even further removed to have provided an operative connection between devices of McClure's SP station (18) and Granzow's ATM (12) to enable delivering and receiving a carrier therebetween.

There is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention. The rejection is clearly based on an attempt at legally impermissible hindsight reconstruction of Appellants' claimed invention. *In re Fritch*, supra. *In re Fine*, supra.

Nor is there any prior art evidence of record of an SP station that is devoted to servicing exterior customers (like McClure's SP station) also being pneumatically connected to a pneumatic tube of an ATM. Again, for many reasons it would not have been obvious to one having ordinary skill in the art to have modified McClure with the ATM of Granzow as alleged. Again, the Office has not presented a *prima facie* showing of obviousness.

The alleged modification to McClure would also destroy the utility and advantage of the McClure teaching. That is, the alleged modification to McClure would render the reference inoperable for its intended and desired purpose. However, an obviousness rejection cannot be based on a combination of features if making the combination would result in destroying the utility or advantage of the device disclosed in the reference. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Action's alleged modification to McClure would destroy McClure's ability to function as McClure requires. Therefore, the alleged combination would not be enabling to one of ordinary skill in the art. However, a rejection based on an alleged combination of features that does not produce an enabled form of what is recited, is not a proper rejection. *In re Kumar*, Case No. 04-1074 Fed. Cir. August 15, 2005.

Furthermore, the evidence of record does not support a desirability to combine the references. Even if it were somehow possible (which it isn't) for the references to have been

structurally and functionally combined as alleged, ability to combine does not equal obviousness. The ability that references *can* be combined does *not* render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir. 1990). *In re Fritch*, *supra*.

Additionally, the evidence of record does not support any objective reason to combine the teachings of the references. Thus, even if it were somehow possible (which it isn't) for the references to have been structurally and functionally combined as alleged, and it were further somehow possible (which it isn't) for the claimed invention to have been within the capabilities of one having ordinary skill in the art, the record still would not be sufficient to establish a *prima facie* case of obviousness. The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Ex parte Levingood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000). *Al-site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

The alleged combination would not have resulted in the recited system

Even if it were somehow possible (which it isn't) for the references to be combined as alleged, the combination still would not have produced Appellants' claimed invention. Adding Granzow's inside ATM (12) next to McClure's SP station (18) would not have resulted in the recited system of claim 1. The proposed addition of Granzow teaching (which does not teach or suggest the recited features and relationships lacking in McClure) to McClure would not have produced the recited invention.

At best, if it were somehow possible (for sake of argument) for the references to be combined as alleged, the modified McClure would have an exterior customer station (10) in

communication with an interior SP station (18) that is isolated from interior customers, an interior walk-up window teller (14), and a stand alone interior ATM (12). McClure's SP station (18) would still be isolated from (not "in operative connection with") Granzow's ATM (12). A missing (operatively connected) link between the SP station (18) and the ATM (12) would still remain missing. That is, even if McClure had the alleged SP and customer stations (18, 10), plus the ATM (12) of Granzow added as an interior customer station, the recited system of Appellants' claims still would not be met. For example, the proposed modification to McClure still would not teach or suggest an SP station's carrier delivery and receiving device in operative connection with a customer station's carrier delivery and receiving device (enabling a carrier carrying a transaction item to be selectively moved between the devices) in the same building.

For reasons previously discussed, McClure's customer station (10) cannot constitute the recited customer station. This is because McClure's customer station (10) is not *in* a building.

For reasons previously discussed, the alleged customer station (Granzow's ATM 12) added in the proposed modification to McClure cannot constitute the recited customer station. This is because the alleged customer station (ATM 12) in Granzow does not teach or suggest a delivery and receiving device for a carrier of a transaction item, especially a device that could deliver and receive McClure's carrier (40).

As previously discussed, the Action itself (on page 4) notes that the SP station (18) of McClure is in a secure room. Thus, even if McClure had (for sake of argument) Granzow's interior ATM (12) (i.e., the alleged customer station), McClure's SP station (18) still would not be operatively connected with the added ATM (to enable a carrier with a transaction item to be selectively moved between the stations).

Therefore, even with the Action's proposed modification to McClure, the recited inside customer station including a carrier delivery and receiving device would be absent. It follows that an inside customer station's carrier delivery and receiving device being in operative connection with an inside SP station's carrier delivery and receiving device, would further be absent.

Thus, even if it were somehow possible (which it isn't) for McClure to have been modified as proposed in the Action, at best the result would still lack SP and customer stations in the same building, with their respective carrier delivery and receiving devices being in operative connection providing the ability of a carrier carrying a transaction item to be selectively moved therebetween.

#### Conclusion of claim 1 remarks

The Office's allegations are not based on any evidence in the record. The record lacks substantial evidence support for the rejection. *In re Zurko*, supra. *In re Lee*, supra.

Nor does the Action explain how McClure could be modified as alleged by the Office. Accordingly, the Action procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

Nor do the applied references teach or suggest the desirability of the combination. *In re Mills*, supra. *In re Fritch*, supra.

The applied references are devoid of any teaching, suggestion, or motivation for combining features thereof so as to produce the recited invention. Again, the attempt to modify McClure with the ATM of Granzow is clearly an attempt at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid

basis for a finding of obviousness. The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Appellants' disclosure.

The applied references, taken alone or in combination, do not teach or suggest all of the recited features and relationships. A *prima facie* case of obviousness has not been established. It would not have been obvious to have modified McClure with the teachings of Granzow as alleged. Nor would the alleged modification of McClure with the teaching of Granzow have resulted in Appellants' recited invention.

For these many reasons, Appellants respectfully submit that the rejection of claim 1 should be reversed.

#### Rebuttal of comments by the Board

The Board (at page 26 of the decision dated July 21, 2005) alleged that "McClure anticipates claim 1 except for the limitation of 'the SP station and the customer station are positioned inside of the building,' a limitation that could be easily addressed as pointed out in our analysis. In our *opinion*, limitations that a customer station is located interior to a building do not form a patentable difference".

Appellants respectfully disagree. The Patent Office (including the Board) bears the burden of citing prior art to support any opinions made. This burden has not been met. Statements of opinion (including the Board's opinion) which are not supported by evidence of record (which is the current situation) do not constitute prior art and are therefore not a legal basis for rejection. *In re Zurko*, supra. *In re Lee*, supra. A rejection (or an affirmance thereof) that is based on mere opinion is also arbitrary and capricious, and constitutes violation of Appellants' rights under both the Patent Statutes and the Administrative Procedures Act.

The Board further alleged (at decision page 8) that "In our *opinion* . . . it would have been obvious to anyone of ordinary skill in the art to locate a customer station inside a building for many reasons, among them to let the customers get out of bad weather, because it would be desirable to locate customer stations where the customer [sic] are, which is often indoors at locations such a [sic] shopping malls, and because there are numerous examples of customer service locations which are located both inside and outside, such as automatic teller machines (ATMs) and food service counters".

Again, the legal burden on the Office has not been met. If the Board is relying on personal knowledge to support their opinions then Appellants request an affidavit according to the provisions of 37 CFR 1.104(d)(2). Otherwise, mere opinions do not constitute factual evidence of record (and may only result in unnecessarily prolonging prosecution, which is the current situation).

Appellants also respectfully submit that the Board appears to have a rather simplified (and incorrect) reading of the Appellants' claimed features. The Board's opinions seem to be focused on locating a customer station inside a building. However, this is not the only customer station feature recited. Appellants respectfully submit that all features of a claim are to be considered and that the claim as a whole must be considered.

Even if the Board's opinions were supported by factual evidence of record (which they aren't), they still would not render as obvious the recited claim as a whole. For example, the Board's opinions seem to ignore the recited relationship between an interior SP station and an interior customer station. Claim 1 recites that "the SP carrier delivery and receiving device is in operative *connection* with the customer carrier delivery and receiving device". As best

understood, the Board's opinion is merely directed to a building having a separate single station, not to operatively connected multiple interior stations (SP station and customer station) that enable a carrier to carry a transaction item therebetween.

The Board decision at page 8 also states that "It is not necessary for the references to be physically combinable" and relies on *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983). Appellants respectfully disagree with the Board concerning the applicability of *In re Sneed* to the currently recited invention. Nevertheless, *In re Sneed* does not uproot the legal requirement that an alleged combination cannot change the principle of operation of the primary reference or render the primary reference inoperable for its intended purpose, which would be the result of the alleged combination in the current rejection (as previously discussed). *In re Gordon*, supra. *In re Ratti*, supra. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Nor does *In re Sneed* avoid the controlling nature of other and more recent case law, such as *In re Kumar*; *In re Mills*; *In re Fritch*; *Ex parte Levengood*; *In re Kotzab*; *Al-site Corp. v. VSI Int'l Inc.*; *In re Zurko*; and *In re Lee*.

Appellants respectfully assert that the rejection of claim 1 should be reversed.

### **Claim 38**

Appellants' remarks in support of the patentability of claim 1 are incorporated herein by reference. The applied references, taken alone or in combination, do not teach or suggest all of the recited features and relationships. For example, the references do not teach or suggest a component of a customer station being positioned in supporting connection with an interior wall within a building's interior area, especially where the customer station has a customer pneumatic tube carrier delivery and receiving device in operative connection with an SP pneumatic tube

carrier delivery and receiving device, where a carrier is enabled to be selectively moved between the customer station and the interior SP station. Where do the references teach or suggest *both* a pneumatic tube SP station in a building's interior area *and* a pneumatic tube customer station component positioned in supporting connection with an interior wall in the same interior area? They don't.

Even if it were somehow possible for the references to have disclosed the features alleged, it still would not have been obvious to have combined the references as alleged. Again, how could Granzow's ATM belts (92, 98) connect to McClure's pneumatic tube (42, 56), especially to enable McClure's carrier (40) to be selectively moved between the added customer station (ATM 12) and the alleged SP station (18) in the proposed modification of McClure? They can't. Again, the alleged modification to McClure would impermissibly destroy the structure, function, utility, and advantage of the McClure teaching. *In re Gordon*, supra. *In re Ratti*, supra.

Additionally, even if it were somehow structurally possible (which it isn't) for the references to be combined as alleged, the combination still would not have produced Appellants' claimed invention. Granzow's ATM (the alleged customer station) has belts (92, 98). McClure's SP station (18) has pneumatic tubes. The alleged combination still would not enable McClure's carrier (40) to be selectively moved between stations.

The record lacks evidence of an ATM having a pneumatic tube instead of belts. Nor would it have been obvious to one of ordinary skill in the art to have replaced the ATM belts of Granzow with pneumatic tubes. Nor has the Office explained how the structure of Granzow's ATM could afford the size/space needed for a pneumatic tube operation. Cost alone would

prohibit use of a pneumatic tube for such a short distance (the width of an ATM). Even present day drive-thru banking (with pneumatic tubes) uses a retractable drawer for the auto lane adjacent an SP window. The prior art of record and the ATM industry as a whole teaches against the alleged combination.

The rejection is clearly based on an attempt at legally impermissible hindsight reconstruction of Appellants' claimed invention. *In re Fritch*, supra. *In re Fine*, supra. The Office has not factually established a *prima facie* conclusion of obviousness.

### **Claim 2**

Claim 2 depends from claim 38. The references further do not teach or suggest that "the customer station is positioned within the interior area of the building". Thus, the customer visual display, customer CCTV camera, customer audio transmitting device, customer audio receiving device, and customer pneumatic tube carrier delivery and receiving device are each positioned inside the same building as the SP station. The recited SP station includes an SP visual display, SP CCTV camera, SP audio transmitting device, SP audio receiving device, and SP pneumatic tube carrier delivery and receiving device. Neither McClure nor Granzow taken alone or in combination disclose or suggest each of these customer station components positioned inside the same building as the SP station components.

Additionally, why would the ATM (12) (i.e., the alleged customer station) of Granzow (which is located very close to the teller 14) need a customer CCTV camera, a customer audio transmitting device, and a customer audio receiving device? The rejection is not reasonable to one having ordinary skill in the art. The rejection is clearly an illogical attempt at legally impermissible hindsight reconstruction of Appellants' claimed invention.

As nothing in the applied art discloses or suggests the recited features and relationships, it is respectfully submitted that the claim is allowable. The Office has not established a *prima facie* case of obviousness. It would not have been obvious to have combined the references as alleged to have produced the recited invention.

### **Claim 3**

Claim 3 depends from claim 2/38. The references further do not teach or suggest that "a plurality of customer stations are positioned within the interior area of the building." The references do not teach or suggest a "lone" customer station positioned inside the same building with an SP station. It follows that they can't teach or suggest a plurality of customer stations positioned inside the same building with an SP station. The Office has not established a *prima facie* case of obviousness. The Office doesn't even allege that the combined references would result in the recited system. Regardless, it would not have been obvious to have combined the references as alleged to have produced the recited invention.

### **Claim 12**

Claim 12 depends from claim 38. The references further do not teach or suggest that "the system comprises a plurality of customer stations" or that a "video and audio connection between the SP station and one of the customer stations is responsive to an input to the communication selector device". The Office has not established a *prima facie* case of obviousness.

### **Claim 14**

Claim 14 depends from claim 38. The references further do not teach or suggest a video switching device that is operative to selectively establish video connections between the SP camera and the customer station display in the manner recited. There is no evidence of record

that the alleged video switching device (60) of McClure is has the capability of video "switching". The Office has not established a *prima facie* case of obviousness.

**Claim 15**

Claim 15 depends from claim 14/38. The references further do not teach or suggest a video material presenting device. The video material presenting device is operative to generate video signals. The video switching device is in operative connection with the video presenting device. The video switching device is operative to selectively connect the video material presenting device to the customer visual display. Claim 38 already recited an SP camera.

The Action (page 4, last paragraph) alleges the recited "video material presenting device" as either the SP display (24) or the SP camera (30) in McClure. The SP display (24) cannot constitute the recited video material presenting device. Why would the SP display (24) be connected to the customer display (29)?

Nor can the SP camera (30) constitute the recited video material presenting device. Claim 38 already recited an SP camera. How can the sole SP camera (30) be both the recited SP camera and the recited video material presenting device? Claim 15 recites that the system *further* comprises a video material presenting device. Regardless, there still isn't any evidence of record that in McClure the alleged video switching device (60) can selectively connect the SP camera (30) (i.e., the alleged video material presenting device) to a customer visual display.

There is no teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' recited invention. The Action is also silent as to how a video material presenting device could be implemented into the combination of references to produce Appellants' invention. The Office has not established a *prima facie* case of obviousness.

### **Claim 16**

Claim 16 depends from claim 15/14/38. Claim 16 recites that “the video switching device is operative to selectively connect the customer visual display to either the video material presenting device or the SP CCTV camera”.

In an exemplary embodiment of the invention, the video material presenting device is able to provide the customer station some video information that is intended to be of interest to the customers who use the system. The video switching device may operate to present the video material on the display of the customer station, except when the customer and the service provider are in communication.

Neither of the references teach or suggest a video switching device operative to selectively connect a customer visual display to either a video material presenting device or an SP camera. As previously discussed, McClure's SP camera (30) can't be both the recited video material presenting device (of claim 15) and the recited SP camera (of claim 38). There is no evidence that McClure teaches or suggests the recited features and relationships, as alleged by the Office. The Office has not established a *prima facie* case of obviousness.

### **Claim 18**

Claim 18 depends from claim 2/38. Claim 18 recites that “the building includes a secure room” and “the SP station is housed in the secure room” and “the customer station is disposed outside of the secure room”. As previously discussed (e.g., claim 2 remarks), the references do not teach or suggest *both* a customer station and an SP station positioned inside the *same* building.

The Action (on page 4) alleges that the teller station (18) in McClure is in a secure room inside the bank/building. The references do not teach or suggest a secure room arrangement in the manner recited. The references do not teach or suggest both a customer station and an SP station positioned inside the same building, with the SP station in a secure room but the customer station outside the secure room. The Office has not established a *prima facie* case of obviousness.

#### **Claim 19**

Claim 19 depends from claim 18/2/38. The references further do not teach or suggest that “the system further comprises a plurality of customer stations in the building, wherein each of the customer stations being in operative connection with the SP station”. The SP station is housed in the building (claim 38). The references do not teach or suggest a plurality of customer stations operatively connected to the same SP station inside a building. Where do the applied references, taken alone or in combination, teach or suggest plural interior customer stations in operative connection with the same interior SP station? They don't. The Office has not established a *prima facie* case of obviousness. The Office doesn't even allege that the combined references would result in the recited system. Regardless, it would not have been obvious to have combined the references as alleged to have produced the recited invention.

#### **Claim 39**

Claim 39 depends from claim 38. Claim 38 recites that a customer station includes a customer pneumatic tube carrier delivery and receiving device. The references further do not teach or suggest that “a plurality of customer pneumatic tube carrier delivery and receiving devices are positioned within the interior area of the building”. Where do the applied references,

taken alone or in combination, teach or suggest a single customer pneumatic tube carrier delivery and receiving device positioned within the interior area of a building? They don't. It follows that they can't teach or suggest a *plurality* of customer pneumatic tube carrier delivery and receiving devices positioned within the interior area of a building, especially a building housing an SP station. The Office has not established a *prima facie* case of obviousness.

#### **Claim 40**

Claim 40 depends from claim 39/38. The references further do not teach or suggest that "a plurality of customer stations are positioned within the interior area of the building". Nor do the references teach or suggest that each of the plural customer stations includes plural components in operative connection with the same interior SP station. Nor do the references teach or suggest that a carrier is enabled to be selectively moved between each customer station and the same SP station. The Office has not established a *prima facie* case of obviousness. The Office doesn't even allege that the combined references would result in the recited system. Regardless, it would not have been obvious to have combined the references as alleged to have produced the recited invention.

#### **The Claims Are Not Obvious Over McClure in view of Granzow and Ramachandran**

Claims 4-11, 20-23, 28-37, and 41-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McClure in view of Granzow and Ramachandran.

The Action (on page 5) admits that McClure/Granzow does not teach or suggest "the details of the customer station as claimed". Appellants respectfully submit that

McClure/Granzow also does not teach or suggest recited relationships among customer station, interior area, interior wall, and supporting connection. As best understood, unless the Action specifically states that it relies on McClure or Granzow for a recited feature, then the Office relies on Ramachandran for that feature.

As discussed in more detail herein, Ramachandran cannot alleviate the admitted and noted deficiencies in McClure/Granzow. Thus, even if it were somehow possible (which it isn't) for McClure/Granzow to be further modified with the teaching of Ramachandran as alleged, the result still would not have produced the recited invention.

#### **Claim 4**

Claim 4 depends from claim 38. For reasons of brevity, Appellants' remarks in support of the patentability of claims 28 and 41 are incorporated herein by reference. The references do not teach or suggest a customer station frame in supporting connection with an interior wall and extending in an opening of the wall. Nor do the references teach or suggest a customer station component in supporting connection with the frame.

Ramachandran cannot alleviate the deficiencies in McClure/Granzow. Ramachandran's ATMs don't have a customer station frame in supporting connection with an interior wall. At best, in Ramachandran a customer has to be located exterior of a bank to use a "through-the-wall" ATM. The Office has not established a *prima facie* case of obviousness.

#### **Claim 5**

Claim 5 depends from claim 4/38. For reasons of brevity, Appellants' remarks in support of the patentability of claim 43 are incorporated herein by reference. The references further do

not teach or suggest a customer station cover movably mounted on a customer station frame that extends in an opening of an interior wall.

For reasons already discussed (claim 43 remarks), the alleged cover (18) in Ramachandran is not movably mounted on and supported by a frame/wall. Thus, the alleged cover (18) in Ramachandran cannot constitute the recited cover. A *prima facie* case of obviousness has not been established.

#### **Claim 6**

Claim 6 depends from claim 38. For reasons of brevity, Appellants' remarks in support of the patentability of claim 43 are incorporated herein by reference. For reasons already discussed (claim 43 remarks), the alleged cover (18) in Ramachandran is not supported by a wall, movably mounted in supporting connection with a building wall, or even near a wall. Thus, the alleged cover (18) in Ramachandran cannot constitute the recited cover (which is movably mounted in supporting connection with a building wall). A *prima facie* case of obviousness has not been established.

#### **Claim 7**

Claim 7 depends from claim 4/38. The references further do not teach or suggest a customer station frame that comprises a door frame. Where do the references teach or suggest a customer station door frame supported by and extending in an opening of an interior wall of a building, and a customer station component in supporting connection with the door frame? As discussed in an exemplary embodiment in the Specification, this frame (94, Figures 5-7) feature enables a customer station to be installed in place of a door that is positioned in an interior building wall.

The Action alleges that Ramachandran's element (40) constitutes a door frame supported by and extending in an interior wall. One skilled in the art would understand that Ramachandran's element (40) is not a door frame. A reading of Ramachandran shows that element (40) is actually a top assembly of a "freestanding" ATM. However, as previously discussed (claim 28 remarks), a freestanding ATM in Ramachandran is not supported by a wall but rather by the floor. It follows that Ramachandran's element (40) cannot constitute the recited door frame. A *prima facie* case of obviousness has not been established.

### **Claim 8**

Claim 8 depends from claim 7/4/38. The references further do not teach or suggest a hinge operatively connected to the door frame nor a cover movably mounted relative to the frame through the hinge. As discussed in an exemplary embodiment in the Specification, hinges (104) enable a mounted customer station cover (68) to be moved between closed and open positions.

Where do the references teach or suggest a customer station door frame extending in an interior wall, a customer component in supporting connection with the door frame, a hinge operatively connected to the door frame, and a cover movably mounted relative to the frame through the hinge? They don't.

The Action alleges that Ramachandran has a cover (18) movably mounted relative to a door frame (40) through a hinge (58). However, Ramachandran's elements (18, 40, 58) are all part of a freestanding ATM (10) which (as previously discussed) is not supported by a wall but rather by the floor. That is, the relied upon teaching in Ramachandran is not even in the ballpark of the recited system. It follows that Ramachandran's element (58) cannot constitute the recited

hinge nor can element (18) constitute the recited cover. A *prima facie* case of obviousness has not been established.

#### **Claim 9**

Claim 9 depends from claim 4/38. The references further do not teach or suggest a subframe in supporting connection with a frame extending in an opening of an interior wall of a building, and where at least one of a customer visual display, a customer camera, or a customer carrier device is in supporting connection with the subframe.

The Action alleges that Ramachandran has a subframe (20, 22, 24, 28, 30). Appellants respectfully disagree that Ramachandran's elements (20, 22, 24, 28, 30) constitute a subframe in the manner recited. Regardless, Ramachandran's elements (20, 22, 24, 28, 30) are all part of a freestanding ATM (10) which (as previously discussed) is not supported by a wall but rather by the floor. It follows that Ramachandran's elements (20, 22, 24, 28, 30) cannot constitute the recited subframe. A *prima facie* case of obviousness has not been established.

#### **Claim 10**

Claim 10 depends from claim 6/38. The references further do not teach or suggest a customer station cover (movably mounted in supporting connection with an interior wall) that includes a generally horizontally extending shelf that enables a customer to conduct writing or other activities on the shelf.

The Action (at page 5, last line) alleges that Ramachandran's freestanding ATM (10) has a shelf (46). The internal tray (46), which is extended only during ATM servicing, would not have been considered (by one having ordinary skill in the art) a shelf for a customer to write on. A *prima facie* case of obviousness has not been established.

### **Claim 11**

Claim 11 depends from claim 6/38. The references further do not teach or suggest a customer station cover (movably mounted in supporting connection with an interior wall) that includes a storage location enabling articles to be stored therein.

The Action (at page 6) alleges that Ramachandran's freestanding ATM (10) has a cover (18) including a storage location (28). However, Ramachandran's element (28) is actually a cash delivery door. Where does Ramachandran teach or suggest that the cash delivery door (28) is part of the alleged cover (18)? A *prima facie* case of obviousness has not been established.

### **Claim 20**

Claim 20 depends from claim 38 and recites product by process. The references do not teach or suggest producing a customer station by producing an opening in an interior wall, positioning a frame in the opening (in supporting connection with the interior wall), and positioning at least one customer station component in supporting connection with the frame.

For reasons of brevity, Appellants' remarks in support of the patentability of claims 4, 28, and 41 are incorporated herein by reference. Again, the references do not teach or suggest a customer station frame in supporting connection with and extending in an interior wall. Nor do the references teach or suggest a customer station component in supporting connection with the frame. A *prima facie* case of obviousness has not been established.

### **Claim 21**

Claim 21 depends from claim 20/38. For reasons of brevity, Appellants' remarks in support of the patentability of claims 6, 28, and 43 are incorporated herein by reference. Again, the references do not teach or suggest a movably mounted customer station cover in supporting

connection with an interior wall, where the cover is movable between a first position overlying a wall opening and a second position where the cover is disposed from the opening. A *prima facie* case of obviousness has not been established.

#### **Claim 22**

Claim 22 depends from claim 21/20/38. For reasons of brevity, Appellants' remarks in support of the patentability of claim 8 are incorporated herein by reference. Again, the references do not teach or suggest a movably mounted customer station cover connected to a frame (in supporting connection with and extending in an interior wall) through a hinge. A *prima facie* case of obviousness has not been established.

#### **Claim 23**

Claim 23 depends from claim 21/20/38. The Action (on page 7) alleges that Ramachandran teaches that “when the cover (18 of fig. 1) is moved to the first position the cover extends in generally abutting relation with the wall and in surrounding relation of the frame (14 of fig. 1)”.

As previously discussed, Ramachandran's element (18) cannot constitute the recited cover nor can element (14) constitute the recited frame. The alleged cover (18) in Ramachandran isn't even near a wall, let alone an interior wall. Nor does Ramachandran's Figure 1 show the alleged cover (18) surrounding the alleged frame (14), as alleged by the Office. The Office has not established a *prima facie* case of obviousness.

#### **Claim 28**

Claim 28 is a product by process claim. Appellants' remarks in support of the patentability of claims 1 and 5 are incorporated herein by reference.

The Action (on page 5) admits that McClure/Granzow does not teach or suggest "the details of the customer station as claimed". Appellants respectfully submit that McClure/Granzow further does not teach or suggest a customer station frame supported in an opening in an interior wall and also a customer station cover mounted in supporting connection with the same interior wall. Ramachandran cannot alleviate the admitted and noted deficiencies in McClure/Granzow.

The Office misinterprets the relied upon Ramachandran reference. Ramachandran discusses both freestanding ATMs and "through-the-wall" ATMs. However, neither of the ATM types discussed by Ramachandran teach or suggest the recited customer station.

Ramachandran discusses freestanding ATMs at col. 1, lines 32-37 and col. 2, lines 9-16. As the name implies (and one having ordinary skill in the art would know), "freestanding" ATMs are not mounted on or against a wall. Ramachandran teaches that the entire freestanding ATM is placed on and supported by the floor. ATMs in the lobby of a bank are freestanding. A lobby ATM *must* (col. 2, line 12) be freestanding, and it requires *surrounding* (col. 2, line 13) floor space that provides access to its several sides. Thus, a "freestanding" ATM of Ramachandran cannot constitute a customer station installed in an opening in an interior wall. Ramachandran's freestanding ATM teaches against and cannot constitute the recited customer station.

Ramachandran discusses "through-the-wall" ATMs at col. 1, lines 25-31. Ramachandran teaches that "through-the-wall" ATMs are specifically designed to be at the exterior wall of a bank to enable (walk-up or drive-up) customers to conduct their transactions without entering the bank. That is, in Ramachandran a customer has to be located exterior of a bank building to use a

"through-the-wall" ATM. Ramachandran's "through-the-wall" ATM teaches against and cannot constitute the recited customer station.

Ramachandran also teaches that a freestanding ATM is advantageously much easier to install (e.g., structurally and financially) than a "through-the-wall" ATM (col. 1, lines 35-37). That is, one skilled in the art would not have even attempted to install a "through-the-wall" ATM on an interior wall of a building. Again, the reference (Ramachandran) that the Office relies upon for the rejection actually teaches against the recited invention (and the rejection).

Ramachandran's teaching against the rejection is further verified exemplified by both McClure and Granzow. McClure (like Ramachandran) teaches that a "through-the-wall" customer station (10) is on an exterior wall. Granzow (like Ramachandran) teaches that a "freestanding" ATM is supported by the floor. Granzow (like Ramachandran) also teaches that a "freestanding" ATM is "inexpensive to implement" (col. 1, lines 54-55) (in comparison to a through-the-wall ATM). Nor could Granzow's ATM (12) be supported by a wall as a "through-the-wall" ATM because Granzow's desired teller station (14) and ATM relationship and operation would be destroyed (e.g., col. 2, lines 26-29).

The Action alleges that Ramachandran has a cover (18) and a frame (14, 16) in supporting connection with an interior wall. However, Ramachandran's elements (14, 16, 18) are all part of a freestanding ATM (10) which (as previously discussed) is *not* supported by a wall (especially an interior wall) but rather by the floor. It follows that Ramachandran's element (18) cannot constitute the recited cover nor can element (14, 16) constitute the recited frame. Ramachandran does not teach or suggest the recited customer station. A *prima facie* case of obviousness has not been established.

The Examiner's bald assertion (on Action page 7) that "taking the teachings of McClure, Granzow, and Ramachandran as a whole" would have (somehow) resulted in the recited invention does not offer any support for or explanation of this conclusion. Nor is the Examiner's assertion based on any evidence of record. However, the law requires that the evidence of record must teach or suggest the recited features. *In re Zurko*, *supra*. *In re Lee*, *supra*.

The applied references, taken alone or in combination, do not teach or suggest all of the recited features and relationships. A *prima facie* case of obviousness has not been established. It would not have been obvious to have modified McClure/Granzow with the teachings of Ramachandran as alleged. Nor would the alleged modification of McClure/Granzow with the teaching of Ramachandran have resulted in Appellants' recited invention.

#### **Claim 29**

Claim 29 depends from claim 28. The references further do not teach or suggest mounting a customer station cover by releasably mounting the cover in supporting connection with an interior building wall. For reasons already discussed, Ramachandran cannot alleviate the admitted and noted deficiencies in McClure/Granzow with regard to the recited customer station cover. A *prima facie* case of obviousness has not been established.

#### **Claim 30**

Claim 30 depends from claim 28. For reasons of brevity, Appellants' remarks in support of the patentability of claims 8 and 22 are incorporated herein by reference. Again, the references do not teach or suggest mounting a customer station cover movably mounted in connection with an interior wall through a hinge connection enabling the cover to move between

a first position overlying a wall opening and a second position disposed from the wall opening.

A *prima facie* case of obviousness has not been established.

### **Claim 31**

Claim 31 depends from claim 30/28. The relied upon Ramachandran does not teach or suggest releasibly locking a customer station cover in the manner recited. Nor does the Action provide any support for the alleged teaching in Ramachandran. A *prima facie* case of obviousness has not been established.

### **Claim 32**

Claim 32 depends from claim 31/30/28. The Action (on page 7) alleges that Ramachandran teaches that “when the cover (18 of fig. 1) is moved to the first position the cover extends in generally abutting relation with the wall and in surrounding relation of the frame (14 of fig. 1)”.

As previously discussed, Ramachandran's element (18) cannot constitute the recited cover nor can element (14) constitute the recited frame. The alleged cover (18) in Ramachandran isn't even near a wall, let alone an interior wall. Nor is it clear how Ramachandran's Figure 1 shows the alleged cover (18) surrounding the alleged frame (14), as alleged by the Office. The Office has not established a *prima facie* case of obviousness.

### **Claim 33**

Claim 33 depends from claim 28. The Action is silent with regard to framing an interior wall opening with an opening bounding frame, and positioning a customer station transaction component in supporting connection with the customer station bounding frame. Regardless, the

applied references, taken alone or in combination, do not teach or suggest the recited features. A *prima facie* case of obviousness has not been established.

**Claim 34**

Claim 34 depends from claim 33/28. For reasons of brevity, Appellants' remarks in support of the patentability of claim 9 are incorporated herein by reference. For reasons already discussed, the references do not teach or suggest supporting a customer station subframe in supporting connection with a customer station interior wall opening bounding frame, or positioning a customer station transaction component in supporting connection with the subframe. A *prima facie* case of obviousness has not been established.

**Claim 35**

Claim 35 depends from claim 33/28. For reasons of brevity, Appellants' remarks in support of the patentability of claim 7 are incorporated herein by reference. For reasons already discussed, the references do not teach or suggest a customer station interior wall opening bounding frame comprising a door frame. The Office has not established a *prima facie* case of obviousness.

**Claim 36**

Claim 36 depends from claim 35/33/28. The references further do not teach or suggest a customer station interior wall opening door frame including two generally parallel vertically extending upright portions. Nor do the references teach or suggest a subframe extending in the interior wall opening between the two upright portions or a customer station transaction component in supporting connection with the subframe.

The Action is silent as to the claimed “upright portions”. Regardless, the applied references, taken alone or in combination, do not teach or suggest the recited features.

Nor is there any teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants’ invention. The Action is also silent as to how door frame “upright portions” could be implemented into the combination of references to produce Appellants’ invention. Thus, Appellants have been left to speculate as to how “upright portions” not shown in any cited reference could be implemented in the applied references. Thus, the Action procedurally fails to establish a *prima facie* case of obviousness. A *prima facie* case of obviousness has not been established.

#### **Claim 37**

Claim 37 depends from claim 28. and recites that “the transaction component is either a visual display, a customer CCTV camera, a customer audio transmitting device, a customer audio receiving device or a customer carrier device.”

For reasons already discussed, the references do not teach or suggest a customer station frame positioned in an interior wall opening in supporting connection with the interior wall, and at least one transaction component (from either a visual display, a customer camera, a customer audio transmitting device, a customer audio receiving device or a customer carrier device) positioned in supporting connection with the frame. The Office has not established a *prima facie* case of obviousness.

#### **Claim 41**

Appellants' remarks in support of the patentability of claims 1 and 28 are incorporated herein by reference. The Action (on page 5) admits that McClure/Granzow does not teach or

suggest "the details of the customer station as claimed". Appellants respectfully submit that McClure/Granzow further does not teach or suggest a building having an interior wall extending in an interior area, where a customer station has a component supporting frame that is supported in an opening in the interior wall. For the many reasons already discussed, Ramachandran's "through-the-wall" ATMs are conventionally designed to be at the exterior wall of a bank to enable (walk-up or drive-up) customers to conduct their transactions without entering the bank (col. 1, lines 25-31). Ramachandran (like McClure/Granzow, as admitted by the Office) does not teach or suggest a customer station installed on an interior wall. A *prima facie* case of obviousness has not been established.

Nor would it have been obvious to have modified McClure/Granzow with Ramachandran's teaching as alleged. Regardless, even if it were somehow possible (which it isn't) for McClure/Granzow to have been modified with the teaching of Ramachandran as alleged, the result still would not have produced the recited invention. The applied references, taken alone or in combination, do not teach or suggest the recited features and relationships.

#### **Claim 42**

Claim 42 depends from claim 41. For reasons of brevity, Appellants' remarks in support of the patentability of claims 3, 12, 19, 24, and 40 are incorporated herein by reference. For reasons already discussed, McClure/Granzow do not teach or suggest the recited features and relationships. Ramachandran does not teach or suggest a plurality of customer stations, each in supporting connection with an interior wall of a building. Thus, Ramachandran cannot alleviate the admitted and noted deficiencies in McClure/Granzow. The Office has not established a *prima facie* case of obviousness.

### **Claim 43**

Appellants' remarks in support of the patentability of claims 1, 28, and 41 are incorporated herein by reference. The Action (on page 5) admits that McClure/Granzow does not teach or suggest "the details of the customer station as claimed". Appellants respectfully submit that McClure/Granzow further does not teach or suggest a customer station cover movably mounted in supporting connection with a building wall. Nor does McClure/Granzow teach or suggest that in a first position of the cover a component of the customer station is manually accessible (through an opening of the cover) by a customer and in a second position of the cover the component is rendered accessible for servicing. As previously discussed in the above described exemplary form of the invention with regard to independent claim 43, hinges (104) enable a mounted customer station cover (68) to be moved between closed and open positions.

The Action (on page 6, lines 1-4) alleges that "Ramachandran teaches wherein the customer station further comprises a cover (18 of fig. 1) . . . wherein the cover (18 of fig. 1) is movably mounted in supporting connection with the wall". That is, the rejection relies on Ramachandran for teaching the recited customer station cover. It follows that a showing that the alleged cover (18) in Ramachandran cannot constitute the recited cover would render the rejection legally invalid.

The claim recites that the customer station's cover is movably mounted in supporting connection with a building wall. The Action is silent as to what element in Ramachandran constitutes the recited building wall. Nevertheless, Ramachandran does not teach or suggest the features attributed thereto.

Appellants respectfully submit that the Office again misinterprets the Ramachandran teaching. Ramachandran's element (18) is a customer fascia panel of a freestanding ATM (10) (col. 4, lines 56-60). For the many reasons already discussed, Ramachandran's freestanding ATMs are not supported by a wall. Thus, the alleged cover (18) in Ramachandran is not supported by a wall, movably mounted in supporting connection with a building wall, or even near a wall. Thus, the alleged cover (18) in Ramachandran cannot constitute the recited cover (which is movably mounted in supporting connection with a *building* wall). A *prima facie* case of obviousness has not been established. Conversely, Appellants have shown that a *prima facie* case of obviousness is absent. It follows that the rejection is invalid.

Ramachandran will be further discussed (as a courtesy to the Office) to prevent additional misinterpretations (and unnecessary prosecution) by the Office. Ramachandran's Figure 4 shows various customer fascias (18, 50, 52), as explained at col. 5, lines 25-43. The customer fascia (18) is for a front loading freestanding type of ATM (i.e., loaded from the customer operation side). The customer fascia (50) is for a rear loading through-the-wall type of ATM (i.e., loaded away from the customer operation side). The customer fascia (52) is for a rear loading freestanding type of ATM. The fascias (50 and 52) for the rear loading ATMs are permanently affixed. The fasteners used are also installed from the inside to prevent removal of these fascias (50 and 52). Where does Ramachandran teach or suggest an ATM with a customer fascia (i.e., the alleged customer station cover) being movably mounted in supporting connection with a building wall?

Again, a *prima facie* case of obviousness has not been established. Nor would it have been obvious to have modified McClure/Granzow with Ramachandran's teaching as alleged.

Regardless, even if it were somehow possible (which it isn't) for McClure/Granzow to have been modified with the teaching of Ramachandran as alleged, the result still would not have produced the recited invention. The applied references, taken alone or in combination, do not teach or suggest the recited features and relationships.

**Claim 44**

Claim 44 depends from claim 43. For reasons of brevity, Appellants' remarks in support of the patentability of claims 6, 21, and 28 are incorporated herein by reference. For reasons already discussed, the references do not teach or suggest a customer station including *both* a cover movably mounted in supporting connection with an interior wall extending in an interior area of a building *and* a customer station component positioned (within the interior area) in supporting connection with the same interior wall. As previously discussed, the references do not teach or suggest a relationship among a customer station cover, customer station component, and interior wall in the manner recited. The Office has not established a *prima facie* case of obviousness.

**The Claims Are Not Obvious Over  
McClure in view of Granzow and Gallacher**

Claims 13, 17, and 24-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McClure in view of Granzow and Gallacher.

The Action (on page 7) admits that McClure/Granzow does not teach or suggest "the limitations as claimed" in claims 13, 17, and 24-27.

The teaching of Gallacher is directed to an ATM and a consultant remote from the ATM. Thus, Gallacher (like McClure) teaches away from having an SP station and customer station component inside the same building.

**Claim 13**

Claim 13 depends from claim 12/38. The references further do not teach or suggest an SP station including an indicator in operative connection with a customer station sensor to enable indication at the SP station of the presence of a person at the customer station.

The Action relies on Gallacher at col. 5, lines 1-4 and col. 8, lines 43-60. However, in Gallacher a consultant is first made aware of the presence of a person at an ATM when the person requests assistance (col. 1, lines 6-9 and 45-49; col. 3, line 65 to col. 4, line 9; Figure 4). Nor does Gallacher teach or suggest an SP station having an indicator that gives an indication of the presence of a person at a customer station. Rather, Gallacher teaches that video communication is simply terminated after the customer leaves the ATM (col. 4, lines 61-64; Figure 4). The Office has not established a *prima facie* case of obviousness.

**Claim 17**

Claim 17 depends from claim 16/15/14/38. The references further do not teach or suggest a video material presenting device comprising a computer in operative connection with a data store that includes data representative of video material. Nor do the references teach or suggest that the computer is also in operative connection with a data transmission line through which the video material is changeable. Gallacher does not teach or suggest the recited features. The Office has not established a *prima facie* case of obviousness.

Nor is there any teaching, suggestion or motivation cited for combining the alleged features of the cited references so as to produce Appellants' invention. The Action is silent as to how a video material presenting device could be implemented into the combination of references to produce Appellants' recited invention. Thus, the Action also procedurally fails to establish a *prima facie* case of obviousness.

#### **Claim 24**

Claim 24 depends from claim 38. The references further do not teach or suggest a queuing device at an SP station. Gallacher does not teach or suggest an SP station queuing device in operative connection with a customer actuatable device of plural customer stations. Gallacher actually teaches against queuing (col. 3, lines 19-34). Gallacher explains that queuing is based on random selection, without any intelligence in the selection process. Contrary to queuing, Gallacher's invention selects the consultant in a non-random (non-queued), intelligent manner.

The Action is silent as to any teaching, suggestion or motivation cited for combining features of the cited references so as to produce Appellants' invention. Nor does the Action explain how an actuatable device and a queuing device could be implemented into the combination of references to produce Appellants' invention. Thus, the Action procedurally and factually fails to establish a *prima facie* case of obviousness.

#### **Claim 25**

Claim 25 depends from claim 24/38. The references further do not teach or suggest an SP station including a communication selector unit in operative connection with a queuing device, where the queuing device is operative to remove from the queue order a customer station

responsive to the selector unit placing the SP station in communication with the customer station. The Action provides no factual support for the assertion of obviousness. The Office has not established a *prima facie* case of obviousness.

**Claim 26**

Claim 26 depends from claim 25/24/38. Gallacher does not teach or suggest an SP station queuing device that is operative to defer placing a customer station in a queue order while the SP station and the customer station are in video and audio communication. Thus, Gallacher cannot overcome the admitted deficiencies in McClure/Granzow. The Office has not established a *prima facie* case of obviousness.

**Claim 27**

Claim 27 depends from claim 26/25/24/38. The references further do not teach or suggest the recited relationships between an SP station queuing device and a customer station presence sensor with regard to a customer. Gallacher does not teach or suggest an SP station queuing device that can again place the same customer station in the queue order after sensing a (new) customer, following the customer station's presence sensor ceasing to sense a (old) customer subsequent to the customer station and the SP station being in communication. The Office has not established a *prima facie* case of obviousness.

## **CONCLUSION**

Each of Appellants' pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features of the applied prior art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,

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(viii)



## CLAIMS APPENDIX

1. A transaction system comprising:

a service provider (SP) station, wherein the SP station is enabled to be operated by a service provider providing a transaction, wherein the SP station includes therein an SP carrier delivery and receiving device and at least one component of:

an SP visual display,

an SP camera,

an SP audio transmitting device,

an SP audio receiving device,

at least one customer station, wherein the customer station is enabled to be operated by a customer requesting a transaction, wherein the customer station includes therein a customer carrier delivery and receiving device and at least one component of:

a customer visual display,

a customer camera,

a customer audio transmitting device,

a customer audio receiving device,

wherein the SP carrier delivery and receiving device is in operative connection with the customer carrier delivery and receiving device, and wherein a carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device,

a building, wherein the SP station and the customer station are positioned inside of the building.

2. A system according to claim 38 wherein the customer station is positioned within the interior area of the building.

3. A system according to claim 2 wherein a plurality of customer stations are positioned within the interior area of the building.

4. A system according to claim 38 wherein the customer station comprises a frame, and wherein the wall comprises an opening, and wherein the frame is in supporting connection with the wall and extends in the opening, and wherein at least one of the customer visual display, customer CCTV camera, customer audio transmitting device, customer audio receiving device, or customer carrier device is in supporting connection with the frame.

5. A system according to claim 4 wherein the customer station further comprises a cover, and wherein the cover is movably mounted on the frame, and wherein the cover is movable to enable access to the opening.

6. A system according to claim 38 wherein the customer station further comprises a cover, and wherein the cover is movably mounted in supporting connection with the wall, and wherein in a first position the cover overlies at least one component among the customer visual display, customer CCTV camera, or customer carrier device, and wherein the cover includes at least one opening, wherein the one component is manually accessible through the at least one opening whereby it is enabled to be operated by a customer in the first position of the cover, and wherein in a second position the cover is disposed from the one component and the component is rendered accessible for servicing.

7. A system according to claim 4 wherein the frame comprises a door frame.

8. A system according to claim 7 and further comprising at least one hinge operatively connected to the door frame, and wherein the cover is movably mounted relative to the frame through the hinge.
9. A system according to claim 4 wherein the frame bounds the opening, and further comprising a subframe in supporting connection with the frame, and wherein the subframe extends in the opening, and wherein at least one of the customer visual display, the customer CCTV camera, or the customer carrier device is in supporting connection with the subframe.
10. A system according to claim 6 wherein the cover includes a generally horizontally extending shelf, whereby a customer is enabled to conduct writing or other activities on the shelf.
11. A system according to claim 6 wherein the cover includes at least one storage location, wherein articles are enabled to be stored in the storage location.
12. A system according to claim 38 wherein the system comprises a plurality of customer stations, and wherein the SP station is in operative connection with a communication selector device, and wherein the video and audio connection between the SP station and one of the customer stations is responsive to an input to the communication selector device.

13. A system according to claim 12 wherein at least one customer station comprises a sensor, wherein the sensor is operative to sense a person positioned adjacent the customer station, and wherein the SP station includes an indicator in operative connection with the sensor wherein an indication is given at the SP station of the presence of the person adjacent the customer station.
14. A system according to claim 38 and further comprising a video switching device in operative connection with the SP station, and wherein the video switching device is operative to selectively establish video connections between the SP CCTV camera and the customer video display on the customer station.
15. A system according to claim 14 wherein the system further comprises a video material presenting device, wherein the video material presenting device is operative to generate video signals, and wherein the video switching device is in operative connection with the video presenting device, and wherein the video switching device is operative to selectively connect the video material presenting device to the customer visual display.
16. A system according to claim 15 wherein the video switching device is operative to selectively connect the customer visual display to either the video material presenting device or the SP CCTV camera.

17. The system according to claim 16 wherein the video material presenting device comprises a computer, and wherein the computer is in operative connection with a data store, and wherein the data store includes data representative of video material, and wherein the computer is in operative connection with a data transmission line, and wherein the video material is changeable through the data transmission line.

18. The system according to claim 2 and wherein the building includes a secure room, and wherein the SP station is housed in the secure room, and wherein the customer station is disposed outside of the secure room.

19. The system according to claim 18 wherein the system further comprises a plurality of customer stations in the building, wherein each of the customer stations being in operative connection with the SP station.

20. The system according to claim 38 wherein the customer station is produced by a method comprising:

producing an opening in the wall,

positioning a frame in the opening in supporting connection with the wall, and

positioning the at least one component in supporting connection with the frame.

21. The system according to claim 20 and wherein the customer station further comprises a cover, the method of producing the customer station further comprising the step of movably mounting the cover in supporting connection with the wall, wherein the cover is movable between a first position overlying the opening and a second position wherein the cover is disposed from the opening.
22. The system according to claim 21 wherein the step of movably mounting the cover comprises operatively connecting the cover to the frame through a hinge.
23. The system according to claim 21 wherein in the first position the cover is in abutting relation with the wall and generally extends in surrounding relation of the frame.
24. The system according to claim 38 wherein the system comprises a plurality of customer stations in operative connection with the SP station, and wherein each customer station includes a device actuatable by a customer at a customer station, and wherein the system further includes a queuing device at the SP station, and wherein the queuing device is in operative connection with each customer actuatable device, and wherein the queuing device is operative to generate an order wherein the order includes data representative of a time sequence in which the actuatable devices at the customer stations were actuated, and wherein the queuing device is operative to indicate data responsive to the order.

25. The system according to claim 24 wherein the SP station further includes a communication selector unit, and wherein the system is operative responsive to inputs to the selector unit to selectively place the SP station in video and audio communication with one of the customer stations, and wherein the selector unit is in operative connection with the queuing device, and wherein the queuing device is operative to remove from the order the data representative of the one customer station responsive to the selector unit operating to place the one customer station and the SP station in communication.

26. The system according to claim 25 wherein the customer actuatable device comprises a customer presence sensor, and wherein the queuing device is operative to defer placing data representative of the one customer station in the order while the SP station and the one customer station are in video and audio communication.

27. The system according to claim 26 and wherein the queuing device is operative to place data representative of the one customer station in the order again after the customer presence sensor ceases to sense the customer adjacent the one customer station subsequent to the one customer station and SP station being in communication, and thereafter again senses a customer.

28. A transaction system including a customer station produced by a method comprising:
- (a) providing an interior building wall including a wall opening therethrough;
  - (b) positioning a frame in the wall opening in supporting connection with the wall;
  - (c) positioning at least one transaction component in supporting connection with the frame; and
  - (d) mounting a cover in supporting connection with the wall in overlying relation of the wall opening, wherein the cover includes a component opening, and wherein when the cover is in overlying relation of the wall opening the transaction component is accessible through the component opening.

29. The system according to claim 28 wherein step (d) comprises releasibly mounting the cover in supporting connection with the wall.

30. The system according to claim 28 wherein step (d) comprises movably mounting the cover in connection with the wall through a hinge connection, wherein the cover is movable

between a first position overlying the wall opening and a second position wherein the cover is disposed from the wall opening.

31. The system according to claim 30 wherein the method further comprises the step of releasably locking the cover in the first position by operatively engaging the cover and the frame in an area disposed from the hinge connection.

32. The system according to claim 31 wherein when the cover is moved to the first position the cover extends in generally abutting relation with the wall and in surrounding relation of the frame.

33. The system according to claim 28 wherein step (b) comprises framing the opening with an opening bounding frame, and step (c) comprises positioning the transaction component in supporting connection with the bounding frame.

34. The system according to claim 33 wherein step (b) further comprises supporting a subframe in supporting connection with the bounding frame, and wherein step (c) comprises positioning the transaction component in supporting connection with the subframe.

35. The system according to claim 33 wherein the bounding frame comprises a door frame, wherein the opening is framed by the door frame.

36. The system according to claim 35 wherein the door frame includes two generally parallel vertically extending upright portions, and wherein step (b) further comprises engaging a subframe extending in the opening between the two upright portions, and wherein step (c) comprises positioning the transaction component in supporting connection with the subframe.

37. The system according to claim 28 wherein the transaction component is either a visual display, a customer CCTV camera, a customer audio transmitting device, a customer audio receiving device or a customer carrier device.

38. A system comprising:

a service provider (SP) station including:

an SP visual display,

an SP CCTV camera,

an SP audio transmitting device and an SP audio receiving device,

an SP pneumatic tube carrier delivery and receiving device,

at least one customer station including:

a customer visual display, wherein the customer visual display is in operative connection with the SP CCTV camera,

a customer CCTV camera in operative connection with the SP display,

a customer audio transmitting device and a customer audio receiving device in operative connection with the SP audio receiving device and SP audio transmitting device, respectively, and

a customer pneumatic tube carrier delivery and receiving device in operative connection with the SP pneumatic tube carrier delivery and receiving device, wherein a carrier is enabled to be selectively moved between the customer station and the SP station, and

a building, wherein the building comprises an interior area which includes an interior wall extending therein, wherein the SP station is housed in the interior area, and wherein at least one component among the customer visual display, customer CCTV camera, customer audio transmitting device, customer audio receiving device and customer carrier device of the customer station is positioned within the interior area in supporting connection with the interior wall.

39. A system according to claim 38 wherein a plurality of customer pneumatic tube carrier delivery and receiving devices are positioned within the interior area of the building.

40. A system according to claim 39 wherein a plurality of customer stations are positioned within the interior area of the building, wherein each customer station includes:

a customer visual display, wherein the customer visual display is in operative connection with the SP station,  
a customer CCTV camera in operative connection with the SP station,  
a customer audio transmitting device in operative connection with the SP station,

a customer audio receiving device in operative connection with the SP station, and  
a customer pneumatic tube carrier delivery and receiving device in operative  
connection with the SP station, wherein a carrier is enabled to be selectively moved between the  
customer station and the SP station.

41. A system comprising:

at least one customer station including at least one component of:

a customer visual display,

a customer CCTV camera,

a customer audio transmitting device,

a customer audio receiving device, and

a customer carrier delivery and receiving device,

a building, wherein the building comprises an interior area which includes an interior wall  
extending therein, wherein the at least one component is in supporting connection with the wall,  
wherein the customer station comprises a frame, and wherein the wall comprises an  
opening, and wherein the frame is in supporting connection with the wall and extends in the  
opening, and wherein the at least one component is in supporting connection with the frame.

42. A system according to claim 41 wherein the system comprises a plurality of customer  
stations, wherein each customer station includes a frame in supporting connection with an  
interior wall of the building, wherein each customer station includes at least one component of a  
customer visual display, a customer CCTV camera, a customer audio transmitting device, a

customer audio receiving device, and a customer carrier delivery and receiving device, and wherein the at least one component of each customer station is in supporting connection with the customer station frame.

43. A system comprising:

at least one customer station including at least one component, wherein the at least one component includes at least one of:

a visual display,

a CCTV camera,

an audio transmitting device,

an audio receiving device, and

a carrier delivery and receiving device,

a building, wherein the building comprises a wall, wherein the at least one component is in supporting connection with the wall,

wherein the customer station further comprises a cover, and wherein the cover is movably mounted in supporting connection with the wall, and wherein in a first position the cover generally overlies the at least one component, and wherein the cover includes at least one opening, wherein the at least one component includes a first component and wherein in the first position of the cover the first component is manually accessible through the at least one opening, whereby the first component is enabled to be operated by a customer in the first position of the cover, and wherein in a second position the cover is disposed from the at least one component and the at least one component is rendered accessible for servicing.

44. A system according to claim 43 wherein the wall is an interior wall extending in an interior area of the building, wherein the at least one component is positioned within the interior area in supporting connection with the interior wall.

(ix)

**EVIDENCE APPENDIX**

(None)

(x)

## **RELATED PROCEEDINGS APPENDIX**

Attached is the decision by the Board of Patent Appeals and Interferences in related Appeal No. 2004-1711. The decision was decided on July 21, 2005.



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

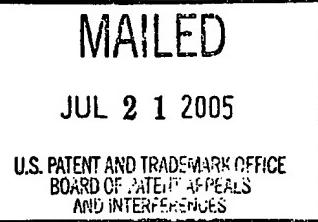
Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte BARTHOLOMEW J. FRAZZITTA,  
RANDOLPH C. BENOIRE,  
DANIEL S. McINTYRE,  
MARK A. DePIETRO,  
and JEFFREY M. KALMAN

Appeal No. 2004-1711  
Application 08/889,033<sup>1</sup>



ON BRIEF

Before BARRETT, BARRY, and BLANKENSHIP, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the non-final rejection of claims 1-47.

We reverse and remand.

<sup>1</sup> Application for patent filed July 7, 1997, entitled "Transaction System," which is based on and claims priority under 35 U.S.C. § 119(e)(1) from U.S. Provisional Application 60/045,794, filed May 7, 1997.

Appeal No. 2004-1711  
Application 08/889,033

BACKGROUND

The invention relates to a system for carrying out transactions, which includes a service provider (SP) station operated by a service provider such as a cashier, clerk, or teller, and a customer station operated by a customer requesting a transaction. An example is a bank customer conducting a transaction with a bank teller. Audio and video communications may be conducted between the SP station and the customer station using cameras, displays, microphones, and speakers. Items may be exchanged between customers and the service provider utilizing carriers transmitted through a pneumatic tube system. Various claims are directed to the mounting and cover structure.

Claim 1 is reproduced below.

1. A transaction system comprising:

a service provider (SP) station, wherein the SP station is enabled to be operated by a service provider providing a transaction, wherein the SP station includes therein an SP carrier delivery and receiving device and at least one component of:

- an SP visual display,
- an SP camera,
- an SP audio transmitting device,
- an SP audio receiving device,

at least one customer station, wherein the customer station is enabled to be operated by a customer requesting a transaction, wherein the customer station includes therein a customer carrier delivery and receiving device and at least one component of:

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a customer visual display,  
a customer camera,  
a customer audio transmitting device,  
a customer audio receiving device,

wherein the SP carrier delivery and receiving device is in operative connection with the customer carrier delivery and receiving device, and wherein a carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device,

a building, wherein the SP station and the customer station are positioned inside of the building.

#### THE REFERENCES

The examiner relies on the following references:

McClure et al. (McClure)	3,294,342	December 27, 1966
Casale et al. (Casale)	5,287,948	February 22, 1994
Kaehler	5,798,931	August 25, 1998 (filed June 6, 1996)
Bustos	5,816,443	October 6, 1998 (filed December 12, 1995)

#### THE REJECTIONS

Claims 1-4, 12, 13, 18, 19, 24-27, 37-42<sup>2</sup>, and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Casale and Bustos.

Claims 5-11, 14-16, 20-23, 28-36, and 43-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Casale, Bustos, and McClure.

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<sup>2</sup> Note that claim 37 depends on claim 28, which is rejected over Casale, Bustos, and McClure. Thus, claim 37 should be grouped with claim 28.

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Claim 17 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Casale, Bustos, McClure, and Kaehler.

We refer to the non-final rejection (Paper No. 17) (pages referred to as "R<sub>\_\_</sub>") and the examiner's answer (Paper No. 22<sup>3</sup>) (pages referred to as "EA<sub>\_\_</sub>") for a statement of the examiner's rejection, and to the supplemental appeal brief (Paper No. 21) (pages referred to as "Br<sub>\_\_</sub>") and reply brief (Paper No. 23) (pages referred to as "RBr<sub>\_\_</sub>") for a statement of appellants' arguments thereagainst.

OPINION

Casale and Bustos

Claim 1

The examiner finds that Casale teaches, expressly or by principles of inherency, the claimed invention except for the customer station being inside the building. The examiner finds that Bustos teaches customer stations inside and outside a building and concludes that it would have been obvious to construct the customer stations inside the building (R6-7; EA5).

Appellants argue that Casale does not disclose the following claimed features of claim 1 (Br15):

- (1) "the SP station and the customer station are positioned inside of the building";

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<sup>3</sup> The examiner's answer mailed July 16, 2003, erroneously has Paper No. 14 on the cover page.

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- (2) an "SP carrier delivery and receiving device" and a "customer carrier delivery and receiving device";
- (3) "the SP carrier delivery and receiving device is in operative connection with the customer carrier delivery and receiving device"; and
- (4) "a carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device."

Appellants note (Br15-16) that the examiner is vague about what constitutes the "customer station" in Casale. It is argued that in Casale customers first place their orders at a menu location 52 and then drive to a pick-up window 22 to pay for and receive the orders, where the transaction occurs by hand at the pick-up window 22 (Br16). It is argued that there is no delivery device at the menu location 52 where the customer places the order and, since the food is handed to the customer, there is no need for a delivery device at the window (Br16). Nor, it is argued, is there a camera, display, audio receiving/transmitting device at the pick-up window 22 (Br16). Appellants further argue that Casale does not disclose a "service provider (SP) station" and the second level housing 14 cannot be the SP station, as asserted by the examiner, because there is no suggestion that it has one of the four components and it also lacks the SP carrier delivery and receiving system (Br17-18).

The examiner finds that the base housing 12 of Casale corresponds to the customer station (EA3).

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We agree with appellants that Casale does not disclose a customer station and an SP station, each having at least one component and a carrier delivery and receiving system, as recited in claim 1. The remotely located menu and order display unit in Fig. 13 is operated by a customer requesting a transaction and has all four of the recited components; this cannot be the claimed customer station because it does not have a "customer carrier delivery and receiving device." As noted by appellants, the customer must go to the window to pick up the meal and there is no reason for any of the components at the pick-up window where there is a live person; thus, the pick-up window cannot be the claimed customer station because it has no components. Furthermore, the window location does not have a "customer carrier delivery and receiving device." The conveyor 90 in Figs. 8-11, 14, and 15 delivers food from the top level to a service person at the bottom level who hands it to the customer through a window, it does not deliver food directly to the customer and the customer does not have access to the conveyor. Thus, even assuming that the conveyor 90 is a "carrier delivery and receiving device," it is not at a customer station even if the remote unit and the pick-up window are somehow considered to be part of an overall customer station (which is not a position set forth by the examiner). The rejection does not rely on Bustos for the customer station, but appellants argue anyway that

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Bustos does not disclose or suggest the recited customer station (Br24-25). The customers in Bustos order items using an electronic entry device 22 associated with a credit card reader and does not require any of the components. We agree with appellants' arguments about Bustos.

Casale also does not teach the claimed SP station having at least one component and a carrier delivery and receiving system. Casale discloses that the customer communicates with a cashier or person taking the order within the base level housing 12 (col. 6, lines 29-35), thus, the visual display, camera, microphone, and speaker for the cashier service provider are in the lower housing near the lower end of the conveyor 90. The lower end of the conveyor cannot be both an SP carrier delivery and receiving system and a customer carrier delivery and receiving system. The examiner does not rely on Bustos, but appellants argue that Bustos does not disclose or suggest the recited SP station (Br26-27). We agree with appellants' arguments about Bustos.

Appellants further argue that Casale does not teach a "customer station ... positioned inside of the building." The examiner relies on Fig. 5D of Bustos as teaching that a customer station can be inside a building (R6). Appellants argue that it would not have been obvious to modify Casale to place customer stations inside the building in view of Bustos because:

- (1) Casale desires customers to remain outside of the building

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(Br20-21); (2) Casale's building is not structurally capable of supporting an interior customer station (Br21-22); (3) Casale has no need of the recited customer station (Br22-23); (4) an interior customer station would destroy the disclosed benefits of Casale (Br23-24); and (5) it would not have been obvious to insert the alleged customer station of Bustos into Casale (Br27).

In our opinion, if Casale taught an outside customer station within the claims, it would have been obvious to anyone of ordinary skill in the art to locate a customer station inside a building for many reasons, among them to let the customers get out of bad weather, because it would be desirable to locate customer stations where the customer are, which is often indoors at locations such a shopping malls, and because there are numerous examples of customer service locations which are located both inside and outside, such as automatic teller machines (ATMs) and food service counters. It is not necessary for the references to be physically combinable. See In re Sneed, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983). Thus, we do not base our decision on the limitation of "positioned inside of the building."

As to the limitations of an "SP carrier delivery and receiving device" and a "customer carrier delivery and receiving device," "the SP carrier delivery and receiving device is in operative connection with the customer carrier delivery and

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receiving device," and "a carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device," appellants argue that both Casale and Bustos are one-way systems that do not disclose or suggest moving a transaction item from a customer station to an SP station and vice versa and are incapable of such function (Br18-20; Br24-25).

We do not find where the examiner addresses these arguments. However, we have considered the references and agree with appellants. The conveyor 90 in Casale is used to deliver items from an upstairs source to a downstairs service person who then delivers it through a window to a customer. Even assuming, arguendo, that the source is the SP station and the end of the conveyor is a customer station, the SP station only delivers and the customer station only receives--they do not each deliver and receive, as claimed. In fact, the conveyor embodiment of Fig. 14 is not capable of delivering to the upstairs station. The conveyor embodiment of Figs. 9-11 might be able to send from the first level to the second level, but is clearly not intended to do so because the food carrier slides down an off-loading ramp 97 and it would be necessary for a person to climb up to put items on the tray 108. Bustos also is a one-way system for delivering items purchased on a credit card or room charge and the like and does not cure the deficiencies of Casale. There is no disclosure

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that guests in Fig. 5D, or in any of the other embodiments, send anything back using the pneumatic tube.

The rejection of claim 1 is reversed because the combination of Casale and Bustos does not teach or suggest: (1) an "SP carrier delivery and receiving device" and a "customer carrier delivery and receiving device"; (3) "the SP carrier delivery and receiving device is in operative connection with the customer carrier delivery and receiving device"; and (4) "a carrier is enabled to be selectively moved with a transaction item between the customer carrier delivery and receiving device and the SP carrier delivery and receiving device."

Claims 38, 2-4, 12, 13, 18, 19, 24-27, and 38-40

The rejection is the same as for claim 1. It is noted that claim 1 recites an "SP carrier delivery and receiving device" and a "customer carrier delivery and receiving device," whereas claim 38 recites an "SP pneumatic tube carrier delivery and receiving device" (emphasis added) and a "customer pneumatic tube carrier delivery and receiving device" (emphasis added).

Claim 38 also differs from claim 1 in requiring all four components of a display, a CCTV camera, an audio transmitting device, and an audio receiving device, whereas claim 1 only requires one of these components. Claim 38 also recites a building with an interior wall and at least one component of the four components and customer carrier device to be in an interior

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area in supporting connection with the interior wall, whereas claim 1 requires the customer station to be positioned inside the building with no limitations on how components are supported.

The rejection does not expressly address the "pneumatic tube" difference. The examiner finds that the "carrier" corresponds to the conveyor trays 94 of Fig. 14 (EA5). However, as appellants point out, the alleged carrier 94 is not associated with a "pneumatic tube" system, but is actually part of a roller and belt arrangement (Br32). That is, the embodiment of Fig. 14 is motor driven (col. 7, lines 52-55), not pneumatic. The embodiment of Figs. 9-11 uses a pneumatic column or track 102 (col. 7, lines 9-14), which perhaps could be considered a pneumatic tube even though it does not correspond to a tube that sends a carrier inside it. Bustos teaches a pneumatic tube delivery system, a one-way system, but the examiner's rejection does not rely on Bustos for this feature.

Appellants arguments parallel those for claim 1 and we reverse the rejection of claim 38 for essentially the same reason as stated in connection with claim 1, i.e., because the combination of Casale and Bustos does not teach or suggest: (1) an "SP pneumatic tube carrier delivery and receiving device" and a "customer pneumatic tube carrier delivery and receiving device"; (2) the customer pneumatic tube carrier delivery and receiving device "in operative connection with the SP pneumatic

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tube carrier and receiving device"; and (3) "wherein a carrier is enabled to be selectively moved between the customer station and the SP station." The rejection of dependent claims 2-4, 12, 13, 18, 19, 24-27, and 38-40 must also be reversed.

Claims 41 and 42

Claim 41 recites a customer station including at least one component, with the component in supporting connection with an interior wall of a building, and "wherein the customer station comprises a frame, and wherein the wall comprises an opening, and wherein the frame is in supporting connection with the wall and extends in the opening, and wherein the at least one component is in supporting connection with the frame." It is noted that the "customer carrier delivery and receiving device" is claimed as one of the components and is not required in addition to one of the four components of visual display, camera, audio transmitting device, and audio receiving device as in claim 1. We interpret a "visual display" to be broad enough to be any kind of visual display, such as the visual display of an ATM.

Appellants argue that the rejection is silent as to what element constitutes the alleged frame and, thus, appellants have been given the undue burden of speculating as to what allegedly constitutes the recited "frame" (Br38). It is true that the rejection appealed from does not mention frames. Appellants note that the examiner alleged in a previous Office action that

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Casale's drive-in window inherently had a "frame" (Br38). Appellants argue that even if the drive-in window in Casale inherently had a frame, there is no indication that it is in supporting connection with an interior wall in an interior area of the building (Br38-39). It is argued that there is no indication that a recited customer station "component is in supporting connection with the frame" because Casale's speaker/microphone, display, and camera are located at the inner housing 52 which is separate and distinct from the alleged frame associated with the drive-in window (Br39). It is further argued that modification of Casale so that a station component is positioned in supporting connection with a window frame would prevent use of the window, destroying the operability of the Casale system (Br39-40). Appellants further argue that Bustos does not disclose or suggest a frame as recited (Br40-41).

The statement of the rejection in the examiner's answer states that "the customer terminal comprises a frame (the drive in window inherently has a frame (a door frame, a window frame or a cashier's access frame) and an opening for customer pick up food or product)" (EA4), which confirms appellants' speculation that the examiner is relying on the window frame. The rejection does not rely on Bustos. The response to the argument section of the answer (EA17) does not respond to appellants' arguments.

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While we agree with the examiner that the windows in Casale inherently have a frame, Casale does not disclose that "at least one component is in supporting connection with the frame." The display, camera, speaker, and microphone components in Casale are disclosed to be located at the inner housing 52 in Fig. 13, which is not at the window. The inner housing 52 is not a wall of a building and, therefore, even if the housing has a frame it is not "in supporting connection with" a wall as claimed. There is no teaching of any component at the window. The conveyor 90 is inside the building and is not at customer station and is not in supporting connection with a frame of the window. The rejection does not rely on Bustos. The combination of Casale and Bustos does not teach a customer station including at least one component "wherein the customer station comprises a frame, and wherein the wall comprises an opening, and wherein the frame is in supporting connection with the wall and extends in the opening, and wherein the at least one component is in supporting connection with the frame." The examiner has failed to establish a prima facie case of obviousness. Thus, the rejection of claims 41 and 42 is reversed.

Claim 47

Claim 47 is directed to a transaction system having an SP station including an SP communication device and a customer station including a customer communication device "in operative

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communication with the SP communication device," both the SP station and customer station positioned inside a building, and including:

a delivery device, wherein the delivery device includes an inner volume therein, wherein the delivery device is adapted to hold a transaction item in the inner volume during a delivery, wherein a transaction item is enabled to be deposited into the inner volume at either of the SP or customer stations, wherein a transaction item is enabled to be received from the inner volume at either of the SP or customer stations, and wherein the delivery device is movable to deliver a deposited transaction item from either of the SP or customer stations to the other respective SP or customer station ....

Appellants argue that Casale does not disclose the delivery device because there is no teaching of a delivery device capable of delivering a transaction item from the alleged customer station on the side at the lower ground level of the building to the alleged SP station on the upper floor of the building, or that the alleged SP station is capable of receiving a transaction item from the alleged customer station (Br43). It is argued that the customer is not inside the building and is not capable of using the alleged carrier (tray 94). It is argued that the alleged carrier (tray 94) points downward on the upward trip which makes it impossible to hold a food product for movement to the second floor and, further, there is no reason to move food items to the second floor (Br43-44). Appellants argue that Casale does not have the recited SP station and customer station in the same building (Br42; Br44-45). It is further argued that

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Bustos does not overcome the deficiencies in Casale and that combining the teaching of Bustos into Casale would not have produced the claimed invention (Br45-47).

The response to the argument section of the answer (EA17) does not respond to appellants' arguments about claim 47.

We agree with appellants that neither Casale nor Bustos teaches the claimed delivery device. The examiner relies on tray 94 in Fig. 14 as the carrier (EA5). The conveyor embodiment 90 of Fig. 14 is not capable of moving items from the lower floor to the upper floor because the trays hang down on the upward trip. Even if the conveyor was capable of two way delivery of items, Casale does not teach that the delivery device connects an SP station with a customer station. The SP station and customer station must each have a communication device. The customer communication devices are located at the inner housing 52, not at the lower end of the conveyor. Furthermore, since the customer picks up the order at the window, the customer station cannot be located at the conveyor. The SP communication devices in Casale are located at the cashier or person taking the order on the first floor (col. 6, lines 29-35), and so the SP station cannot be located at the upper end of the conveyor. It is not necessary to address appellants' other arguments. The examiner has failed to establish a prima facie case of obviousness. The rejection of claim 47 is reversed.

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Casale, Bustos, and McClure

Dependent claims 5-11, 14-16, and 20-23

The examiner adds McClure to the combination of Casale and Bustos for the rejection of claims 5-11, 14-16 and 20-23, which depend on claim 38, for the teaching of a cover.

While McClure teaches the limitations of independent claim 38, except for at least one component in supporting connection with an interior wall, which could be easily dealt with, the rejection does not apply McClure for this purpose. Since appellants have not been given notice that McClure could be applied to claim 38, reliance on McClure for the limitations of claim 38 would raise a new ground of rejection. See In re Kronig, 539 F.2d 1300, 1302, 190 USPQ 425, 426 (CCPA 1976) (The "ultimate criterion" of whether a rejection is new is "whether appellants have had a fair opportunity to react to the thrust of the rejection."). We decline to enter a new ground of rejection because it would mean that we would have to examine the claims in the first instance. Even if McClure did teach the limitations of the claims to which it is applied, it has not been applied by the examiner to cure the deficiencies of Casale and Bustos as to claim 38. Accordingly, the rejections of claims 5-11, 14-16, and 20-23 are reversed.

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Claims 28-37

Claim 28 is directed to a transaction system including a customer station produced by the steps of providing an interior building wall with an opening; positioning a frame in the wall opening in supporting connection with the wall; positioning a transaction component in supporting connection with the frame; and mounting a cover in supporting connection with the wall overlying the wall opening, wherein the cover includes a component opening and wherein when the cover is in overlying relation to the wall opening, the transaction component is accessible through the component opening. This is illustrated in Fig. 4 which shows a customer interface area 70 of a cover 68 having carrier opening 72 to access the pneumatic tube carrier delivery and receiving device 24, screen access opening 78 to view a display 80, camera viewing opening 82 to allow a camera to view a customer, and an access opening 85 for accessing an accessory such as the telephone handset 86 (specification, page 15). Claim 28 is interpreted to be a product by process claim since it is directed to a system made by certain steps. It is noted that claim 28 recites that the customer station includes a "component" accessible through a component opening in the cover, but does not define the component. It is also noted that the claim does not recite how the cover is mounted, so cover

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could be permanently affixed; compare "movably mounted" in claim 43.

Appellants argue that: (1) McClure does not disclose a customer station on an interior building wall (Br68-69); (2) McClure does not disclose a customer station having a cover with a component opening (Br69); (3) McClure desires the customer to remain outside of the building (Br69-70); (4) it would not have been obvious to insert the customer station of McClure into Casale/Bustos (Br70); and (5) the combined teachings of McClure and Casale/Bustos would still not produce the claimed invention with a cover on an interior wall (Br70-71).

The examiner asserts that all the limitations are taught by the combination of Casale and Bustos except for the cover which is alleged to be taught by the cover 36 in McClure (EA6; EA22).

We do not agree with the examiner's finding (EA7; EA22) that the claimed "cover" corresponds to the door 36 in Figs. 1 and 3 of McClure because the door does not have a component opening. Appellants' arguments that "McClure does not disclose a customer station having a cover with a[] [component] opening" (Br69) and "[n]or does McClure disclose that a transaction component is accessible when the cover is in overlying relation of a wall opening" (Br69) are based on the examiner's erroneous reading of the claimed cover on door 36. We find that there is a cover over the front of the customer station in Figs. 1-3 of McClure,

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although it is not identified by an element number. The cover "component opening" can be the opening covered by the door 36 for access to the carrier delivery and receiving device because claim 38 is open-ended and does not preclude the opening from having a separate cover. The opening for the speaker/microphone 31 is also a component opening because the speaker/microphone is "accessible" in the sense that a user can listen and speak to it. The cover must be attached to some kind of frame to support the various components as shown in Figs. 2 and 3. Claim 28 does not recite that the cover is movably mounted in supporting connection to the wall; compare claim 43.

However, McClure does not disclose that the frame is installed in an opening in the wall. It is not disclosed how the frame is installed. It would seem that the examiner could have easily found a teaching of installing a component in an opening in a wall, such as an ATM machine, but this has not been done. Moreover, McClure does not disclose that the customer station is installed in an interior wall. While we consider this an easily addressable limitation, we will not enter a new ground of rejection. Casale does not disclose a component of a customer station in a wall, much less an interior wall. While Bustos discloses a component in a wall, see Fig. 5C (not cited or relied upon by the examiner), the wall is not disclosed to be an interior wall; and while Bustos discloses a component in the

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interior of a building, see Fig. 5D, the pneumatic carrier delivery device is not installed in a wall, but comes out at the top of the cabinet in the room. The rejection does not tie up all these loose ends and we decline to enter a new ground of rejection by adding further reasoning. We conclude that the examiner has failed to establish a prima facie case of obviousness. The rejection of claims 28-37 is reversed.

Claims 43 and 44

Claim 43 recites a system having a customer station including at least one component, the component being in supporting connection to the wall of a building, and:

wherein the customer station further comprises a cover, and wherein the cover is movably mounted in supporting connection with the wall, and wherein in a first position the cover generally overlies the at least one component, and wherein the cover includes at least one opening, wherein the at least one component includes a first component and wherein in the first position of the cover the first component is manually accessible through the at least one opening, whereby the first component is enabled to be operated by a customer in the first position of the cover, and wherein in a second position the cover is disposed from the at least one component and the at least one component is rendered accessible for servicing.

It is noted that the "carrier delivery and receiving device" is claimed as one of the components and is not required in addition to one of the four components of a visual display, a camera, an audio transmitting device, and an audio receiving device as in claim 1. It is noted that the wall does not have to be an "interior wall" as in claim 38. It is noted that the component

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must be "manually accessible" through the cover, as opposed to claim 28 which only says that the component is "accessible."

Appellants argue that McClure does not disclose a system having a customer station component enabled to be operated by a customer through an opening in a cover movably mounted in supporting connection with a building wall, nor does McClure disclose that the component is accessible for servicing when the cover is moved to a second position (Br72). It is argued that the alleged cover 36 of McClure lacks an opening and does not permit operation of a component in the manner recited (Br73). It is further argued that McClure does not disclose a cover movable to a first position and a second position (Br73). It is argued that Casale, Bustos, and McClure alone or in combination fail to disclose or suggest the claimed features and relationships and there is no motivation for combining features (Br73-74).

The examiner asserts that all the limitations are taught by the combination of Casale and Bustos except for the cover which is alleged to be taught by the cover 36 in McClure (EA6; EA22).

Appellants' arguments that McClure does not disclose a system having a customer station component enabled to be operated by a customer through an opening in a cover is based on the examiner's erroneous reading of the claimed cover on door 36. As noted in the discussion of claim 28, we find that there is a cover over the front of the customer station in Figs. 1-3 of

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McClure, although it is not identified by an element number, and the carrier delivery and receiving device is manually accessible by a user through the opening (the claim does not preclude having a door over the opening). However, even if we were to go beyond the examiner's rejection, McClure does not disclose that the "cover is movably mounted in supporting connection with the wall" and has a first position where the component is manually accessible by a customer and a second position where the component is rendered accessible for servicing. For these reasons, the examiner has failed to establish a prima facie case of obviousness. The rejection of claims 43 and 44 is reversed.

Claims 45 and 46

Claim 45 recites a customer station including at least one component, with the component in supporting connection with an interior wall of a building, "wherein the customer station is produced by a method comprising the steps of: producing an opening in the wall, positioning a frame in the opening in supporting connection with the wall, and positioning the at least one component in supporting connection with the frame." Claim 45 is an odd claim in that it is a system claim having method of making steps. We interpret claim 45 as a product by process claim which results in the same structure as claim 41. We interpret the limitation of "producing an opening in the wall" to

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include both building a wall with an opening and building a wall without an opening and then creating an opening.

Since claim 45 is of essentially the same scope as claim 41 except in product by process form, it is not clear why the examiner has applied McClure. The examiner has generally applied McClure to teach a cover, but no cover is recited in claim 45.

Appellants arguments regarding Casale and Bustos (Br74-78) basically repeat the arguments with respect to claim 41.

Appellants argue that: (1) the customer station in McClure is located outside of a building; (2) McClure desires the customers to remain outside of the building in their automobiles for convenience to the customer and safety for the teller; (3) there is no indication of a customer station frame positioned in supporting connection with a frame positioned in an opening of an interior wall of a building; (4) it would not have been obvious for the alleged frame of the banking customer station to be positioned in supporting connection with an interior wall in the interior area of Casale; and (5) McClure cannot overcome the deficiencies in Casale/Bustos (Br78-79).

For the reasons stated in connection with claim 41, which is of commensurate scope, the rejection of claims 45 and 46 is reversed.

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Casale, Bustos, McClure, and Kaehler

Claim 17

The examiner adds Kaehler for the rejection of dependent claim 17, which depends on claim 16. Kaehler does not cure the deficiencies with respect to the rejection of claim 38. Thus, the rejection of claim 17 is reversed.

Remand to consider relevant prior art

The Board reviews the rejections before us, not rejections that could have been formulated from the same references. We are generally reluctant to suggest that the best art has not been applied to the claims on appeal since appellants have spent years responding to examiners' rejections. Nevertheless, in this case, we feel that a remand is necessary because McClure has clearly not been used to its best advantage and because we feel McClure must be considered before the case can be allowed.

McClure was cited to the Office in appellants' initial Information Disclosure Statement (Paper No. 2, filed October 23, 1998). It is clear from the similarities of Fig. 5 of McClure to Fig. 8 of the present invention that appellants were well aware of McClure when the application was filed; while Fig. 1 of McClure is modernized in appellants' Fig. 4, the basic components are all present in a walk-up customer station. McClure also discloses many of the stated advantages of appellants' invention, including providing security for the teller and the fact that

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tellers can provide other banking duties during non-service periods of a customer at a customer station. It is not known why the examiner did not apply McClure as a primary reference since it is much better than Casale and Bustos. For example, McClure anticipates claim 1 except for the limitation of "the SP station and the customer station are positioned inside of the building," a limitation that could be easily addressed as pointed out in our analysis. In our opinion, limitations that a customer station is located interior to a building do not form a patentable difference. McClure is a much better reference as to the other claims as well. We remand for the examiner to consider McClure.

As to the cover limitations, although we have noted that McClure discloses a cover which meets some cover limitations, we recommend that, on remand, the examiner consider a reference such as Ramachandran et al. (Ramachandran), U.S. Patent 5,483,047, issued January 9, 1996 (copy attached). Ramachandran shows an ATM having a fascia 18 (corresponding to a cover) which is pivotable between a first position where components are accessible through openings in the fascia and a second position where the components are accessible for servicing; see Figs. 2, 4, and 6. Ramachandran also discloses that it was known to mount ATM units inside the wall of a bank with the customer interface extending though the wall of the bank or freestanding in the lobby of a bank or other commercial establishment (col. 1,

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lines 24-37). Many of the cover limitations are taught or suggested by Ramachandran.

As further guidance, we advise the examiner that the statements that "the various mechanical details listed in claims 5-11, 14-16, 20-23, 28, and 43-46, such as a cover, a door frame, at least one hinge, at least one storage, a sub-frame ... are notoriously well known in the art as a design choice" (EA7) and "[t]he specific mechanical shapes claimed are believed to be merely aesthetic design choice and are in any case not critical to the invention" (EA7) are not considered to be proper obviousness reasons. The examiner should address the obviousness of the structural limitations, preferably with a reference, rather than relying on design choice and non-criticality.

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CONCLUSION

The rejections of claims 1-47 are reversed.

The application is remanded for consideration of prior art.

REVERSED AND REMANDED

*Lee E. Barrett*  
LEE E. BARRETT )  
Administrative Patent Judge )

*Lance L. Barry*  
LANCE LEONARD BARRY )  
Administrative Patent Judge )

*Howard B. Blankenship*  
HOWARD B. BLANKENSHIP )  
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